88-1804

No. 89-____

Supreme Court, U.S.
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IN THE

Supreme Court of the United States

OCTOBER TERM, 1988

CBS INC.,

Petitioner,

—v.—

STEPHEN M. SILVERMAN,

Respondent.

APPENDIX TO THE PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SECOND CIRCUIT

DAVID RABINOWITZ
(Counsel of Record)
STANLEY ROTHENBERG
CYNTHIA S. KERN

MOSES & SINGER
1271 Avenue of the Americas
New York, New York 10020
(212) 246-3700

Attorneys for Petitioner,
CBS Inc.

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UNITED STATES COURT OF APPEALS

FOR THE SECOND CIRCUIT

Docket No. 88-7165

Filed February 6, 1989

At a stated Term of the United States Court of Appeals for the Second Circuit, held at the United States Courthouse in the City of New York, on the sixth day of February one thousand nine hundred and eighty-nine.

Present: HON. WILFRED FEINBERG
HON. JON O. NEWMAN
HON. GEORGE C. PRATT
Circuit Judges,

STEPHEN M. SILVERMAN,

Plaintiff-Appellant,

—v.—

CBS INC.,

Defendant-Appellee.

Appeal from the United States District Court
for the Southern District of New York

This cause came to be heard on the transcript of record from the United States District Court for the Southern District of New York and was argued by counsel.

ON CONSIDERATION WHEREOF, it is now hereby ordered, adjudged and decreed that the judgment of said District Court be and it hereby is affirmed in part, vacated in part and

remanded without costs to the said district court for further proceedings in accordance with the opinion of this court.

A TRUE COPY
ELAINE B. GOLDSMITH,
Clerk

By: /s/ FRED M. CASSIDY
Deputy Clerk

Elaine B. Goldsmith,
Clerk

by: /s/ EDWARD J. GUARDARO
Edward J. Guardaro,
Deputy Clerk

ISSUED AS MANDATE:
March 8, 1989

UNITED STATES COURT OF APPEALS

FOR THE SECOND CIRCUIT

No. 1175—August Term 1987

Argued: May 25, 1988 Decided: February 6, 1989

Docket No. 88-7165

STEPHEN M. SILVERMAN,

Plaintiff-Appellant,

—v.—

CBS INC.,

Defendant-Appellee.

Before:

FEINBERG, NEWMAN, and PRATT,

Circuit Judges.

Appeal from a judgment of the District Court for the Southern District of New York (Gerald L. Goettel, Judge) awarding defendant damages, declaratory relief, and an injunction in a copyright and trademark suit arising from the efforts of plaintiff to develop a musical based on the "Amos 'n' Andy" characters.

Affirmed in part, vacated in part, and remanded.

BARRY I. FREDERICKS, New York, N.Y. (Aurnou & Fredericks, New York, N.Y., on the brief), *for plaintiff-appellant.*

DAVID RABINOWITZ, New York, N.Y. (Stanley Rothenberg, Moses & Singer, New York, N.Y., on the brief), *for defendant-appellee.*

JON O. NEWMAN, *Circuit Judge*:

This appeal presents somewhat novel issues of both copyright and trademark law arising from the efforts of appellant Stephen M. Silverman to develop a musical based on the "Amos 'n' Andy" characters.[1] The attempt to transport Amos, Andy, Kingfish, Algonquin J. Calhoun, and all the others from the well-known radio and television shows of earlier decades to Broadway (possibly in a cab of the Fresh Air Taxi Co.) has thus far been stymied by the assertion of copyright and trademark infringement claims by appellee CBS Inc. Silverman appeals from a judgment of the District Court for the Southern District of New York (Gerald L. Goettel, Judge) awarding CBS damages, declaratory relief, and an injunction. Because some "Amos 'n' Andy" materials are in the public domain while others remain subject to CBS copyrights, and because CBS has elected not to make commercial use of its "Amos 'n' Andy" radio and television programs, nor create new ones, since 1966, the issues pri-

1 In this litigation, the phrase has been variously spelled "Amos 'n' Andy," "Amos 'N' Andy," and "Amos 'n Andy." For convenience, we will spell it "Amos 'n' Andy" except when referring to it as a trademark, where it will appear as AMOS 'N' ANDY.

marily raised on this appeal are the extent of copyright protection available to CBS with respect to the "Amos 'n' Andy" characters and whether CBS has abandoned through non-use whatever trademarks it might have. We conclude that to a limited extent copyright infringement has occurred, that the declaratory and injunctive relief awarded CBS should be modified to avoid extension of copyright protection to public domain materials, that Silverman is entitled to limited declaratory relief, and that CBS's trademarks, if valid, have been abandoned.

Facts

The "Amos 'n' Andy" characters were created in 1928 by Freeman F. Gosden and Charles J. Correll, who wrote and produced for radio broadcasting "The Amos 'n' Andy Show." The show became one of the country's most popular radio programs. The characters in the Amos 'n' Andy programs were Black. Gosden and Correll, who were White, portrayed Amos and Andy on radio. The authors appeared in blackface in publicity photos. Black actors played the parts in the subsequent television programs.

Gosden and Correll assigned all of their rights in the "Amos 'n' Andy Show" scripts and radio programs to CBS Inc. in 1948. Gosden and Correll continued to create new "Amos 'n' Andy" scripts, which formed the basis for CBS radio programs. The radio programs continued until 1955. Beginning in 1951 CBS also broadcast an "Amos 'n' Andy" television series. The television series was aired on CBS affiliate stations until 1953 and continued in reruns and non-network syndication until 1966. CBS has not aired or licensed for airing any of the radio or television programs since 1966.

In 1981, Silverman began writing a script for a Broadway musical based on the "Amos 'n' Andy" characters. The title of this work was originally "Amos 'n' Andy Go To The Movies." A revision was titled "Amos 'n' Andy In Hollywood," and a more extensive revision was titled "Fresh Air Taxi." Silverman sought a license to use the "Amos 'n' Andy" characters, but CBS refused.

Silverman filed this lawsuit seeking a declaration that the "Amos 'n' Andy" radio programs broadcast from March 1928 through March 1948 (the "pre-1948 radio programs") are in the public domain and that he is therefore free to make use of the content of the programs, including the characters, character names, and plots. He also sought a declaration that CBS has no rights in these programs under any body of law, including statutory and common law copyright law and trademark law. CBS asserted five counterclaims: (1) that Silverman's scripts infringed CBS's copyrights in the scripts for three post-1948 radio programs; (2) that the Silverman scripts violated section 43(a) of the Lanham Act, 15 U.S.C. § 1125(a) (1982), by infringing various CBS trademarks, including "AMOS 'N' ANDY", the names of various characters such as "George ('Kingfish') Stevens," "Madame Queen," and "Lightnin'," and various phrases such as "Scuse me for protruding," "splain dat," and "Holy mackral" (perhaps Amos's best-known contribution to the language); (3) that the infringement of CBS's trademarks also violated CBS's rights under state unfair competition and anti-dilution law; (4) that Silverman had misappropriated CBS's goodwill associated with the "Amos 'n' Andy" programs and trademarks; and (5) that Silverman had obtained improper copyright registration of his first movie script, claiming it to be an original work,

whereas it used protected material from scripts in which CBS held copyrights.

District Court Decisions

Judge Goettel adjudicated the plethora of issues before him in three stages, writing thoughtful opinions at each stage. The initial decision granted in part and denied in part CBS's motion for summary judgment. *Silverman v. CBS*, 632 F. Supp. 1344 (S.D.N.Y. 1986) (hereafter "*Silverman I*"). Judge Goettel ruled initially that since all of the works in which CBS claims a statutory copyright were created long before January 1, 1978, the effective date of the 1976 Copyright Act, 17 U.S.C. §§ 101-914 (1982 and Supp. IV 1986), the copyright issues were primarily governed by the Copyright Act of 1909. Act of March 4, 1909, ch. 320, 35 Stat. 1075. The District Judge then considered CBS's copyright claims with respect to the pre-1948 radio programs, the post-1948 radio programs, and the television programs.

With respect to the pre-1948 radio programs, Judge Goettel ruled that the scripts for these programs were in the public domain because the copyrights in these scripts, originally obtained by Gosden and Correll, had not been renewed. *Id.* at 1350. He also ruled that the broadcasts of these programs (presumably the audiotapes of the broadcasts) were entitled to common law copyright protection because the broadcasts did not constitute publication, and publication had not otherwise occurred. *Id.* That ruling, however, does not appear to have affected the judgment that was ultimately entered. The District Judge did not rule that Silverman's scripts infringed CBS's rights in the pre-1948 broadcasts, nor did he rule that Silverman was entitled to a declaration of the right to use material from

these broadcasts. Judge Goettel expressed the view that though CBS had the right to prevent copying of "the sound recordings of the radio shows," CBS's rights in the pre-1948 programs were "immaterial" because Silverman did not plan to use recordings of these programs in his musical.[2] *Id.*

Turning next to the post-1948 radio programs, Judge Goettel ruled that CBS had common law copyrights in the scripts for these programs, which became statutory copyrights pursuant to the 1976 Act when CBS registered these scripts with the Copyright Office in early 1985. *Id.* at 1351. The District Judge then found that Silverman had had access to the scripts and had listened to the broadcasts, that the first script for his musical indisputably contained substantial portions of dialogue from at least one of the post-1948 radio scripts, and that Silverman was therefore liable for copyright infringement.[3] *Id.* at 1351-52.

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2 Though the District Court may have been correct in concluding that it is "immaterial" whether CBS retains copyrights in the pre-1948 radio broadcasts, its suggestion that CBS has copyrights in the sound recordings is incorrect. These sound recordings were made prior to February 15, 1972, the date as of which Congress first extended copyright protection to sound recordings. Act of October 15, 1971, P.L. 92-140, 85 Stat. 391, as amended by Act of December 31, 1974, P.L. 93-573, 88 Stat. 1873. As sound recordings, they therefore are not eligible for federal copyright protection. *See Lone Ranger Television, Inc. v. Program Radio Corp.*, 740 F.2d 718, 720 (9th Cir. 1984); 1 *Nimmer on Copyright* § 2.10[B] (1988). If Silverman had planned to play the audiotapes of these broadcasts in his musical, CBS would have had to look to state law for protection. *See Goldstein v. California*, 412 U.S. 546 (1973). CBS makes no claim that it might have some basis for claiming infringement if Silverman sought to use, not the actual sounds contained on these tapes, but only some increments of expressive content beyond what is contained in the public domain scripts, *e.g.*, ad-libbed dialogue or a further delineation of a character. We express no views on the availability of such a claim.

3 The District Court's opinion refers to infringement of both the post-1948 scripts and the post-1948 programs. Since the infringing material

Summary judgment was granted to CBS on its first and fifth counterclaims.

Turning next to the television programs, the District Judge noted that CBS had obtained copyright registrations and renewals for the televised programs (which were fixed in the tangible medium of film or videotape). He then rejected Silverman's claim that CBS had placed these telecasts in the public domain by publishing them without copyright notice. Recognizing that broadcasting the television programs was not publication, Silverman had nevertheless contended that CBS had made a sufficiently broad distribution of the progams to constitute publication by reason of the distribution of copies of the programs to affiliate and non-affiliate stations. Silverman relied primarily on the practice known as "bicycling," whereby one television station forwards the program to another. Judge Goettel expressed some doubt that the record assembled on summary judgment supported the claim, but ruled in any event that distribution of copies for "synchronized national broadcast" was not a general publication. *Id.* at 1353-54.

Then, facing the issue of the scope of copyright protection for the television programs, Judge Goettel focused on the graphic representation of the "Amos 'n' Andy" characters in the telecasts. Mindful that the pre-1948 radio scripts were in the public domain, he framed the key question to be "are characters that are in the public domain in a literary work protectable by copyright in an audiovisual presentation?" *Id.* at 1355. The District Judge answered "yes" and ruled that "duplication of the characters as

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was dialogue that appeared in one of the scripts, it is the copyright in that script that was infringed. The programs added no additional dialogue that was copied by Silverman's script for his musical.

they appeared on television would infringe CBS's copyrights." *Id.* Reaching the issue of infringement, Judge Goettel then ruled that substantial similarity could not be determined until the characters in Silverman's musical were seen on stage, and he therefore dismissed the counterclaim as unripe to the extent that it sought relief for infringement of the television programs. *Id.*

On the trademark side of the case, Judge Goettel ruled that the name "Amos 'n' Andy," as well as the names and appearances of "Amos 'n' Andy" characters and "other distinctive features of the . . . radio and television shows" are protectable marks. *Id.* at 1356. He then set down for trial the issue of whether CBS's non-use of the marks constituted abandonment. Finally, he ruled that the issue of trademark infringement, as well as the related issues of unfair competition and dilution were premature in the absence of a staging of Silverman's musical. *Id.* at 1357-58.

After a bench trial on the issue of abandonment, Judge Goettel concluded that CBS had not abandoned its trademarks. *Silverman v. CBS*, 666 F. Supp. 575 (S.D.N.Y. 1987) (*Silverman II*). Finally, upon CBS's motion for damages and an award of attorney's fees, the District Judge ordered Silverman to pay damages of $9,403.07 (representing the difference between $20,000 of revenue received from backers of his musical and expenses of $10,596.93), plus an attorney's fee of $10,000. *Silverman v. CBS*, 675 F. Supp. 870 (S.D.N.Y. 1988) (*Silverman III*).

The final judgment entered in the District Court included several provisions. Silverman was enjoined from "creating . . . distributing . . . or offering for sale any script, or permitting the display or performance publicly of any musical play based thereon, bearing or containing

any substantial copy or derivative work based upon any episode of an Amos 'n' Andy radio or television program created by or for CBS in or after August 1948 . . . ." He was also ordered to recall and deliver to CBS copies of the scripts titled "Amos 'n' Andy in Hollywood" and "Amos 'n' Andy Go To The Movies." The judgment declared that Silverman's copyright registration in his first script was void, that CBS's copyright registrations in episodes of the "Amos 'n' Andy" radio and television programs are valid, that the "characters' names and appearances and other distinctive features" of the "Amos 'n' Andy" radio and television shows are trademarks of CBS, and that CBS has not abandoned such marks. CBS was awarded damages and attorney's fees totaling $19,403.07. Finally, the judgment dismissed with prejudice all claims and counterclaims except CBS's second, third, and fourth counterclaims, which were dismissed without prejudice. This dismissal of all claims resulted in the denial of Silverman's claim for a declaration of his right to use any of the component parts of the pre-1948 radio programs, including the programs' titles, characters, characters' names, and plots. Though *Silverman I* had determined that the scripts for the pre-1948 radio programs were in the public domain, Silverman obtained no rights to their use because of the District Court's ruling that "AMOS 'N' ANDY" and the "Amos 'n' Andy" characters and phrases were protected trademarks of CBS.

Discussion

We consider first the trademark side of this case because our conclusion on the trademark issues significantly alters the context in which the copyright issues arise.

1. *Trademark Issues.* Silverman challenges the District Court's rulings that CBS has protectable trademarks in the "Amos 'n' Andy" names, characters, and other features of the radio and television programs, including phrases of dialogue, and that CBS has not abandoned these marks. We find it unnecessary to decide which features of the programs might give rise to protectable marks because we agree with Silverman that CBS has abandoned the marks.

Section 45 of the Lanham Act provides:

> A mark shall be deemed to be "abandoned"—
>
> (a) When its use has been discontinued with intent not to resume. Intent not to resume may be inferred from circumstances. Nonuse for two consecutive years shall be prima facie abandonment.

15 U.S.C. § 1127 (1982). There are thus two elements for abandonment: (1) non-use and (2) intent not to resume use. *See Saratoga Vichy Spring Co. v. Lehman*, 625 F.2d 1037, 1043 (2d Cir. 1980). Two years of non-use creates a rebuttable presumption of abandonment. *Id.* at 1044.

On the undisputed facts of this case, CBS made a considered decision to take the "Amos 'n' Andy" television programs off the air. It took this action in response to complaints by civil rights organizations, including the NAACP, that the programs were demeaning to Blacks. By the time the abandonment issue came before the District Court, non-use of the AMOS 'N' ANDY marks had continued for 21 years. Although CBS has no current plans to use the marks within the foreseeable future, CBS asserts that it has always intended to resume using them at some point in the future, should the social climate become more hospitable.

Ordinarily, 21 years of non-use would easily surpass the non-use requirement for finding abandonment. *See, e.g., I.H.T. Corp. v. Saffir Publishing Corp.*, 444 F. Supp. 185 (S.D.N.Y. 1978) (denying preliminary injunction to protect trademark after 12 years of non-use). The District Court concluded, however, that CBS had successfully rebutted the presumption of abandonment arising from its prolonged non-use by offering a reasonable explanation for its decision to keep the programs off the air and by asserting its intention to resume use at some indefinite point in the future. This conclusion raises a question as to the proper interpretation of the statutory phrase "intent not to resume": Does the phrase mean intent *never* to resume use or does it merely mean intent not to resume use within the reasonably foreseeable future?

We conclude that the latter must be the case. The statute provides that intent not to resume may be inferred from circumstances, and two consecutive years of non-use is prima facie abandonment. Time is thereby made relevant. Indeed, if the relevant intent were intent never to resume use, it would be virtually impossible to establish such intent circumstantially. Even after prolonged non-use, and without any concrete plans to resume use, a company could almost always assert truthfully that at some point, should conditions change, it would resume use of its mark.

We do not think Congress contemplated such an unworkable standard. More likely, Congress wanted a mark to be deemed abandoned once use has been discontinued with an intent not to resume within the reasonably foreseeable future. This standard is sufficient to protect against the forfeiture of marks by proprietors who are temporarily unable to continue using them, while it also

prevents warehousing of marks, which impedes commerce and competition.

We are buttressed in this conclusion by the fact that the statute requires proof of "intent not to resume," rather than "intent to abandon." The statute thus creates no state of mind element concerning the ultimate issue of abandonment. On the contrary, it avoids a subjective inquiry on this ultimate question by setting forth the circumstances under which a mark shall be "deemed" to be abandoned. Of course, one of those circumstances is intent not to resume use, which is a matter of subjective inquiry. But we think the provision, by introducing the two concepts of "deemed" abandonment and intent not to resume use, contemplates a distinction, and it is a distinction that turns at least in part on duration of the contemplated non-use.

Congress's choice of wording appears to have been deliberate. One early version of what became section 45 of the Lanham Act had provided that "[i]ntent to *abandon* may be inferred from the circumstances." H.R. Rep. 4744, 76th Cong., 1st Sess. (1939) (emphasis added). However, shortly thereafter a new bill modified this phrase by substituting "[i]ntent not to resume" for "[i]ntent to abandon." H.R. Rep. 6618, 76th Cong., 1st Sess. (1939). Though it has been suggested that the phrases are interchangeable, *see* Note, 56 Fordham L. Rev. 1003, 1020 n.113 (1988), we agree with the Fifth Circuit that the phrases are better understood as having distinct meanings. *See Exxon Corp. v. Humble Exploration Co.*, 695 F.2d 96, 102, 103 n.7 (5th Cir. 1983). "Abandonment" connotes permanent relinquishment. *See Webster's Third New International Dictionary* 2 (1981) (defining "abandon" to mean "to cease to assert . . . an interest . . .

esp. with the intent of *never* again resuming or reasserting it) (emphasis added). We think that Congress, by speaking of "intent not to resume" rather than "intent to abandon" in this section of the Act meant to avoid the implication that intent never to resume use must be shown.[4]

This approach is consistent with our recent decisions concerning trademark abandonment. In *Saratoga Vichy Spring Co. v. Lehman*, *supra*, we rejected a claim of abandonment based on seven years of non-use where the initial decision to cease use resulted from a decision of the state legislature and the state, which was the trademark owner, continuously sought to sell the mark along with the mineral water business to which it applied. Similarly, in *Defiance Button Machine Co. v. C & C Metal Products Corp.*, 759 F.2d 1053 (2d Cir.), *cert. denied*, 474 U.S. 844 (1985), we rejected an abandonment claim where, during a brief period of non-use, the proprietor tried to sell the mark, its associated goodwill, and some other assets and, upon failing to find a buyer, became a subsidiary of a company in its original line of trade and prepared to resume its business. In both cases, the proprietor of the mark had an intention to exploit the mark in the reasonably foreseeable future by resuming its use or permitting its use by others.

The undisputed facts of the pending case are entirely different. Unlike the proprietors in *Saratoga Vichy* and

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4 An early Supreme Court case involving abandonment under pre-Lanham Act, common law trademark said that proof of abandonment must include proof of an "intent to abandon." *Saxlehner v. Eisner & Mendelson Co.*, 179 U.S. 19, 31 (1900). In cases applying the Act, we have also on occasion used the phrase "intent to abandon," *see Saratoga Vichy Spring Co. v. Lehman*, *supra*, 625 F.2d at 1044, but decisions using the phrase have not faced the issue whether the requisite intent is never to resume use or not to resume in the reasonably foreseeable future. Where that choice matters, as in this case, the statutory phrase "intent not to resume" better describes the requisite mental element.

Defiance Button, CBS has not been endeavoring to exploit the value of its marks, failing to do so only because of lack of business opportunities. Instead, it has decided, albeit for socially commendable motives, to forgo whatever business opportunities may currently exist in the hope that greater opportunities, unaccompanied by adverse public reaction, will exist at some undefined time in the future.

A proprietor who temporarily suspends use of a mark can rebut the presumption of abandonment by showing reasonable grounds for the suspension and plans to resume use in the reasonably foreseeable future when the conditions requiring suspension abate. *See, e.g., Star-Kist Foods, Inc. v. P.J. Rhoades & Co.*, 769 F.2d 1393 (9th Cir. 1985); *Chandon Champagne Corp. v. San Marino Wine Corp.*, 335 F.2d 531, 535 (2d Cir. 1964); *Continental Distilling Corp. v. Old Charter Distillery Co.*, 188 F.2d 614, 619-20 (D.C. Cir. 1950). But a proprietor may not protect a mark if he discontinues using it for more than 20 years and has no plans to use or permit its use in the reasonably foreseeable future. A bare assertion of possible future use is not enough.

We recognize the point, forcefully made by Judge Goettel, when he wrote:

> It would be offensive to basic precepts of fairness and justice to penalize CBS, by stripping it of its trademark rights, merely because it succumbed to societal pressures and pursued a course of conduct that it reasonably believes to be in the best interests of the community.

Silverman II, 666 F. Supp. at 581. Nonetheless, we believe that however laudable one might think CBS's motives to be, such motives cannot overcome the undisputed facts that CBS has not used its marks for more than 20 years

and that, even now, it has no plans to resume their use in the reasonably foreseeable future. Though we agree with Judge Goettel that CBS should not be penalized for its worthy motive, we cannot adjust the statutory test of abandonment to reward CBS for such motive by according it protection where its own voluntary actions demonstrate that statutory protection has ceased. Moreover, we see nothing in the statute that makes the consequence of an intent not to resume use turn on the worthiness of the motive for holding such intent.

We are also mindful of the facts, relied on by the District Court, that show some minor activities by CBS regarding its properties, allegedly sufficient to rebut abandonment of the marks. These are CBS's actions in licensing the programs for limited use in connection with documentary and educational programs, challenging infringing uses brought to its attention, renewing its copyrights, and periodically reconsidering whether to resume use of the programs. But challenging infringing uses is not use, and sporadic licensing for essentially non-commercial uses of a mark is not sufficient use to forestall abandonment. *Cf. Exxon Corp. v. Humble Exploration Co.*, *supra*, 695 F.2d at 102 (use must be "commercial use" to avoid abandonment). Such uses do not sufficiently rekindle the public's identification of the mark with the proprietor, which is the essential condition for trademark protection, nor do they establish an intent to resume commercial use. CBS's minor activities, like worthy motives for non-use, cannot dispel the legal consequence of prolonged non-use coupled with an intent not to resume use in the reasonably foreseeable future. *See Kirkland v. National Broadcasting Co.*, 425 F. Supp. 1111, 1117-18 (E.D. Pa. 1976), *aff'd mem.*, 565 F.2d 152 (3d Cir. 1977)

(abandonment after 23-year period without commercial exploitation).

An adjudication of trademark rights often involves a balancing of competing interests. *See La Societe Anonyme des Parfums Le Galion v. Jean Patou, Inc.*, 495 F.2d 1265, 1274 n.11 (2d Cir. 1974). In weighing the competing interests and reaching our conclusion concerning abandonment, we are influenced in part by the context in which this dispute arises—one in which the allegedly infringing use is in connection with a work of artistic expression. Just as First Amendment values inform application of the idea/expression dichotomy in copyright law, *see Harper & Row, Publishers, Inc. v. Nation Enterprises*, 471 U.S. 539, 556 (1985), in similar fashion such values have some bearing upon the extent of protection accorded a trademark proprietor against use of the mark in works of artistic expression.

Ordinarily, the use of a trademark to identify a commodity or a business "is a form of commercial speech and nothing more." *Friedman v. Rogers*, 440 U.S. 1, 12 (1979). Requiring a commercial speaker to choose words and labels that do not confuse or deceive protects the public and does not impair expression. *See, e.g., United States v. Ninety Five Barrels, More or Less, Alleged Cider Vinegar*, 265 U.S. 438, 443 (1924) ("It is not difficult to choose statements, designs and devices which will not deceive."); *cf. Vidal Sassoon, Inc. v. Bristol-Myers Co.*, 661 F.2d 272, 276 n.8 (2d Cir. 1981) (First Amendment concerns do not justify alteration of normal standard of preliminary injunctive relief on Lanham Act claim involving shampoo advertisements).

In the area of artistic speech, however, enforcement of trademark rights carries a risk of inhibiting free expres-

sion, *cf. L.L. Bean, Inc. v. Drake Publishers, Inc.*, 811 F.2d 26, 28-29 (1st Cir.), *cert. denied*, 107 S. Ct. 3254 (1987), not only in the case at hand but in other situations where authors might contemplate use of trademarks in connection with works of artistic expression. These risks add some weight to Silverman's claims.[5]

From the standpoint of the proprietor of a mark in a work of artistic expression, there is also an interest in expression, along with the traditional trademark interest in avoiding public confusion as to source. Trademark law can contribute to a favorable climate for expression by complementing the economic incentive that copyright law provides to create and disseminate artistic works, *see Harper & Row Publishers, Inc. v. Nation Publishers*, *supra*, 471 U.S. at 558. In this case, however, the expression interest on CBS's side is markedly diminished by its decision to withhold dissemination of the works with which its marks are associated.

The interest of CBS, and the public, in avoiding public confusion, an interest obviously entitled to weight in every trademark case, is also somewhat diminished in the context of this case. This interest is not as weighty as in a case involving a non-artistic product whose trademark is associated with high quality or other consumer benefits. Though Silverman undoubtedly hopes that some of his audience will be drawn from those who favorably recall the "Amos 'n' Andy" programs, we doubt if many who attend Broadway musicals are motivated to purchase tickets because of a belief that the musical is produced by the

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5 Although *Dallas Cowboys Cheerleaders, Inc. v. Pussycat Cinema, Ltd.*, 604 F.2d 200 (2d Cir. 1979), rejected a movie theater's First Amendment defense to a trademark infringement claim, that ruling was in the context of a pornographic film that used blatantly false and misleading advertisements.

same entity responsible for the movie, book, or radio or television series on which it is based. That is not to say that the musical is in a sufficiently distinct line of commerce to preclude all protection; the holder of a mark associated with a television series would normally be entitled to "bridge the gap" and secure some protection against an infringing use of the mark in connection with a Broadway musical. It is to say, however, that most theater-goers have sufficient awareness that the quality of a musical depends so heavily on a combination of circumstances, including script, score, lyrics, cast, and direction that they are not likely to be significantly influenced in their ticket-purchasing decision by an erroneous belief that the musical emanated from the same production source as the underlying work.

The point must not be overstated. Trademark protection is not lost simply because the allegedly infringing use is in connection with a work of artistic expression. But in determining the outer limits of trademark protection—here, concerning the concept of abandonment—the balance of risks just noted is relevant and in some cases may tip the scales against trademark protection. These considerations are especially pertinent in the pending case where some aspects of the material claimed to be protected by trademark are in the public domain as far as copyright law is concerned.

For all of these reasons, we conclude that the undisputed facts establish abandonment of the AMOS 'N' ANDY marks.

2. *Copyright Issues.* As a result of our ruling on the trademark side of the case, it becomes more important than it was in the District Court to determine the extent to which CBS's copyrights prevent Silverman from proceed-

ing with his musical. Judge Goettel, though acknowledging that the pre-1948 radio scripts were in the public domain as far as copyright law was concerned, gave Silverman no declaration of any rights concerning the "Amos 'n' Andy" characters because of his ruling on the trademark side of the case. Our rejection of that ruling thus alters the context in which the copyright issues arise.

On this appeal, Silverman does not challenge the District Court's finding that his script for his musical infringes CBS's copyright in at least one of CBS's post-1948 radio scripts. He does assert the right to use the pre-1948 radio scripts and also contends that CBS lost its copyright in the television programs by distributing ("bicycling") them to local television stations without copyright notice affixed. In the view we take of this case, the rights of the parties that need to be adjudicated at this time may be determined without resolution of the validity of the CBS copyrights in the television programs. The validity of those copyrights appears to turn on the precise factual circumstances surrounding the distribution of the television programs, and those circumstances have not been sufficiently developed on this record. Development of that factual record, however, may await the production of Silverman's musical, since until then (and perhaps even after that point) the pending CBS claim of copyright infringement and Silverman's claim to a declaration of right to make some use of the "Amos 'n' Andy" material may be adjudicated without consideration of the validity of CBS's copyrights in the television programs.

The fundamental copyright principle applicable to this case is that a copyright affords protection only for original works of authorship and, consequently, copyrights in derivative works secure protection only for the incremen-

tal additions of originality contributed by the authors of the derivative works. *See* 1 *Nimmer on Copyright* §§ 2.01, 3.04 (1988). Thus, the CBS copyrights in the post-1948 radio scripts programs, and whatever rights it may have in the television scripts and programs (assuming for the moment that the programs have not been published without copyright notice) provide protection only for the increments of expression beyond what is contained in the pre-1948 radio scripts, which are in the public domain. This principle is fully applicable to works that provide further delineation of characters already sufficiently delineated to warrant copyright protection. *See Burroughs v. Metro-Goldwyn-Mayer, Inc.*, 683 F.2d 610, 631 (2d Cir. 1982) (Newman, J., concurring).

This basic principle has some favorable consequences for both CBS and Silverman. For CBS, it means, as the District Court determined, that CBS is entitled to prevail on its claim that Silverman's script infringes the CBS copyright in at least one of the post-1948 radio scripts because significant dialogue appearing in that script (and not contained in the pre-1948 scripts) has been copied by Silverman in his script for his musical. For Silverman, the basic copyright principle means that he is entitled to use the public domain material from the pre-1948 scripts and may do so up to the point at which he copies original expression added to the pre-1948 radio scripts and protected by valid CBS copyrights.

With respect to the "Amos 'n' Andy" characters, which are at the heart of this litigation, we have no doubt that they were sufficiently delineated in the pre-1948 radio scripts to have been placed in the public domain when the scripts entered the public domain. *See Nichols v. Universal Pictures Corp.*, 45 F.2d 119 (2d Cir. 1930), *cert. denied*,

282 U.S. 902 (1931). What Silverman may not use, however, is any further delineation of the characters contained in the post-1948 radio scripts and the television scripts and programs, if it is ultimately determined that these last items remain protected by valid copyrights.

Judge Goettel recognized the basic principles that apply to the copyright claims of both sides but in one respect misapplied them, according CBS too much protection in implementing his conclusion that "characters that are in the public domain in a literary work [are] protectable by copyright in an audiovisual work." *Silverman I*, 632 F. Supp. at 1355. Though he correctly observed that "[t]he visual representation of these characters, recorded on film, is the expression of an idea that goes beyond the word portraits in the public domain scripts," he erred in concluding that "duplication of the characters as they appeared on television would infringe CBS's copyrights." *Id.* Since only the increments of expression added by the films are protectable, Silverman would infringe only if he copies these protectable increments. It is, of course, likely that the visual portrayal of the characters added something beyond the delineation contained in the public domain radio scripts, but surely not every visual aspect is protected. For example, the fact that the characters are visibly Black does not bar Silverman from placing Black "Amos 'n' Andy" characters in his musical, since the race of the characters was a feature fully delineated in the public domain scripts. Similarly, any other physical features adequately described in the pre-1948 radio scripts may be copied even though those characteristics are visually apparent in the television films or tapes.

3. *Relief.* There remains the determination of appropriate relief. Since Silverman does not challenge the award

of damages for infringement of the post-1948 radio scripts, those damages and the related attorney's fees in the total amount of $19,403.07 are affirmed.

The situation concerning non-monetary relief is somewhat more complicated. The judgment awards CBS an injunction barring Silverman from creating a script, or a musical based on a script, "containing any substantial copy or derivative work based upon any episode of an Amos 'n' Andy radio or television program created by or for CBS in or after August 1948." It is not clear whether this injunction is designed to prohibit copying of any aspect of the post-1948 programs or, because of the word "episode," to prohibit copying only the plots of such episodes. The first possibility is too broad, and the second could be both too broad and too narrow (too broad if some of the plots were in the public domain pre-1948 radio scripts and too narrow if the post-1948 copyrightable materials contain protectable elements in addition to plots).

What the injunction should prohibit is copying any of the protectable elements of the works in which CBS holds valid copyrights. Those works include the post-1948 radio scripts, the television scripts, and possibly the television programs (depending on the ultimate outcome of the "bicycling" dispute). The protectable elements of these copyrighted materials are those elements that constitute increments of expression additional to what is contained in the pre-1948 radio scripts and that satisfy the minimal copyright requirement of originality. Framing an injunction in terms of a legal conclusion concerning protectable increments of expression is not entirely satisfactory, but the alternative of trying to identify at this stage every protectable element of the copyrighted materials is even less

satisfactory. Precise determination of such elements will have to await the situation, should it ever arise, where Silverman prepares a script that arguably infringes a protectable element of these materials and CBS asserts a claim of infringement. If in such a proceeding CBS claims that Silverman has infringed the protectable elements of a television program, the "bicycling" issue will also have to be determined.

We also defer precision in framing relief on Silverman's claim for a declaratory judgment. Silverman should now receive a declaration that he is entitled to use all aspects of the "Amos 'n' Andy" materials, including names, stories, and characters, to the extent that such elements of expression are contained (or, in the case of characters, to the extent delineated) in the pre-1948 radio scripts, which are in the public domain. As with the injunction, it is not satisfactory to leave the scope of this declaration imprecise, but it would be less satisfactory to attempt to identify all the unprotected elements that Silverman is free to use.

On balance, we think we have adjudicated the legal rights of Silverman and CBS sufficiently to minimize the likelihood of further controversy. Though future disputes might arise, Silverman will now have ample latitude to proceed with his musical, though observing the copyrights that CBS indisputably holds in the post-1948 radio scripts, and he may find it unnecessary to test the full extent of CBS's rights in other materials. With this opinion at hand, we will expect the parties to cooperate in either framing an agreed upon form of judgment for submission to the District Court on remand, or at least narrowing any disputes they may have and submitting variations of language only as to such disputes. In the event of a subsequent appeal

from the entry of judgment upon remand, this panel will retain jurisdiction.

The judgment of the District Court is affirmed in part and vacated in part. Specifically, paragraphs 2, 4, 6, and 8 of the judgment are affirmed; paragraphs 1, 3, 5, and 7 are vacated;[6] paragraph 9 is affirmed to the extent that it dismisses CBS's second, third, and fourth counterclaims without prejudice and in all other respects is vacated; and the cause is remanded to the District Court for entry of a revised judgment, including declaratory and injunctive relief to CBS and declaratory relief to Silverman, all in accordance with this opinion.

Affirmed in part, vacated in part, and remanded. No costs.

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6 Paragraph 7 allowed CBS its costs in the District Court. Our vacatur of that paragraph is without prejudice to such award of costs incurred in the trial court as the District Court may deem appropriate in view of the ultimate disposition of this litigation.

UNITED STATES DISTRICT COURT

S.D. NEW YORK

No. 84 Civ. 1894 (GLG)

April 14, 1986

STEPHEN M. SILVERMAN,

Plaintiff,

v.

CBS INC.,

Defendant.

Wofsey, Certilman, Haft, Lebow & Balin, New York City (Barry I. Fredericks and Jonathan D. Davis, of counsel), and Arrow, Edelstein, Gross & Asher, New York City, for plaintiff.

Moses & Singer, New York City (David Rabinowitz, Stanley Rothenberg and Erica Weissman, of counsel), for defendant.

OPINION

GOETTEL, District Judge:

The plaintiff in this action, Stephen M. Silverman, seeks a declaration regarding his right to use parts of the "Amos 'n' Andy" radio programs broadcast from March 1928, through March 1948, in a Broadway musical comedy he has written. The defendant, CBS Inc., claims to hold valid copyrights as well as trademark rights in the Amos 'n' Andy radio and television programs, and asserts counterclaims against Silverman for, *inter alia*, copyright infringement, trademark infringement, and unfair competition. Before the Court is CBS's motion for summary judgment seeking (1) dismissal of the complaint and (2) determination of liability on its counterclaims.

I. BACKGROUND

Beginning in 1928, Freeman F. Gosden ("Gosden") and Charles J. Correll ("Correll") created and broadcast a radio program known as "The Amos 'n' Andy Show." On August 19, 1948, Gosden and Correll assigned all of their rights in the Amos 'n' Andy scripts and radio programs, along with any goodwill attached to their creations, to CBS. Under the same agreement, Gosden and Correll continued to create new scripts for CBS. CBS broadcast "The Amos 'n' Andy Show" on radio until 1955. Beginning in 1951, CBS also broadcast an "Amos 'n' Andy" television series. The television series aired on network affiliate stations until 1953, and continued in nonnetwork syndication until 1966.

In 1981, the plaintiff began writing a script for a Broadway musical comedy based on the characters of Amos and Andy. In an effort to avoid potential litigation, the plaintiff asked CBS for a license to use the Amos 'n' Andy characters in his script. CBS refused the plaintiff's request. The plaintiff nevertheless completed his script and sought financial backing for a Broadway production.

In early 1984, the plaintiff filed this action seeking a declaration that the "Amos 'n' Andy" radio programs broadcast from March 1928, through March 1948, are in the public domain and that, therefore, he is free to make use of any parts of these programs. The plaintiff seeks a further declaration that CBS has no rights in these programs "under statutory or common law copyright and trademark, common law unfair competition, state anti-dilution law, common law or statutory rights of privacy or publicity, or any other jurisprudential theory." Complaint ¶ 1.b at 8. The plaintiff contends that CBS has abandoned any trademark rights it may have had, because it has not used any Amos 'n' Andy trademarks for twenty years and has failed to police the use of these marks by others.

In April 1984, the defendant moved to dismiss the complaint for lack of a justiciable controversy. In an oral decision on June 8, 1984, we denied the defendant's motion noting that (1) the plaintiff had already made substantial preparations to produce his play, (2) threats of suits against other users of the Amos and

Andy characters created a substantial likelihood that CBS would similarly assert its rights against Silverman, and (3) the likelihood of a suit by CBS was making it difficult for the plaintiff to obtain the financial backing necessary for his production.

In early 1985, CBS amended its answer and asserted five counterclaims: (1) copyright infringement, (2) trademark infringement under section 43(a) of the Federal Trademark Act of 1946, 15 U.S.C. § 1125(a) (1982), (3) common law trademark infringement and unfair competition, (4) misappropriation of CBS's goodwill associated with the "Amos 'n' Andy" trademarks, and (5) improper registration of one of the plaintiff's scripts as an original work. The defendant now seeks summary judgment on these counterclaims and dismissal of the plaintiff's complaint. The plaintiff argues that numerous issues of fact mandate denial of summary judgment. He also seeks sanctions under Rule 11, claiming that the defendant's motion is harassing and brought in bad faith.

The instant summary judgment motion addresses the plaintiff's first script, entitled "Amos 'n' Andy Go To The Movies."[1] In opposing this motion, the plaintiff has submitted a revised script, entitled "Fresh Air Taxi." He has purportedly deleted all dialogue and descriptions identified by CBS in its moving papers as infringing. CBS has not specifically addressed whether "Fresh Air Taxi" infringes its copyrights. However, it contends that (1) the plaintiff's creation and distribution of "Amos 'n' Andy Go To The Movies" has already infringed its copyrights, and (2) any play based on the Amos 'n' Andy characters will infringe its copyrights and trademarks, and

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1 Sometime between May 1984, and June or July 1984, the plaintiff made some minor changes in his script, including changing the title to "Amos 'n' Andy In Hollywood." Silverman Deposition at 11-13, 35-36, 42. According to CBS, these changes do not affect its claim of copyright infringement as presented in this motion. Defendant's Memorandum in Support of Motion for Summary Judgment at 9 n. 2. The plaintiff has recently made more substantial script changes and retitled his work "Fresh Air Taxi." (See text immediately following note.) For the sake of simplicity, all references herein to "Amos 'n' Andy Go To The Movies," or the plaintiff's early script, shall also refer and apply to "Amos 'n' Andy In Hollywood."

constitute unfair competition and dilution of its marks. Consequently, we must consider whether CBS has valid copyrights and/or trademark rights in the Amos 'n' Andy shows and, if so, whether the plaintiff has infringed those rights. For the reasons stated below, the defendant's motion for summary judgment is granted in part and denied in part.

II. DISCUSSION

Rule 56 of the Federal Rules of Civil Procedure states that summary judgment shall be granted if "there is no genuine issue as to any material fact and that the moving party is entitled to a judgment as a matter of law." Fed.R.Civ.P. 56(c). The burden is on the moving party to demonstrate an absence of material factual dispute. *Heyman v. Commerce and Industry Insurance Co.*, 524 F.2d 1317, 1320 (2d Cir.1975). It is incumbent upon the court in deciding whether there is any genuine factual issue to resolve all ambiguities and draw all reasonable inferences against the moving party. *Universal City Studios, Inc. v. Nintendo Co.*, 746 F.2d 112, 115 (2d Cir.1984); *EEOC v. Home Insurance Co.*, 672 F.2d 252, 257 (2d Cir.1982).

A. *Copyright*

The copyright laws protect original works of authorship, "that is, the author's tangible expression of his ideas." *Mazer v. Stein*, 347 U.S. 201, 214, 74 S.Ct. 460, 468, 98 L.Ed. 630 (1954). Copyright protection arises when a work is created and gives the author certain exclusive rights for a limited period of time. The requirements for, and duration of, copyright protection vary, depending on the law in effect when a work was created. The current Copyright Act, 17 U.S.C. §§ 101-914 (1982 & Supp. II 1984), was enacted October 19, 1976 (the "1976 Act"), and became effective January 1, 1978, long after the works at issue in this action were created. Consequently, our examination of copyrights for the Amos 'n' Andy radio and television shows must focus on the Copyright Act of 1909 (the "1909 Act"). *See Walt Disney Productions v. Air Pirates*, 581 F.2d 751, 754 (9th Cir.1978), *cert. denied sub nom. O'Neill v. Walt*

Disney Productions, 439 U.S. 1132, 99 S.Ct. 1054, 59 L.Ed.2d 94 (1979).

Under the 1909 Act, an author could secure copyright by publishing a work with the required copyright notice. 1909 Act § 9.[2] He could then obtain registration of his copyright by depositing two copies of the work with the Copyright Office. 1909 Act §§ 10, 12.[3] If the author never reproduced his work for sale, he could secure copyright registration by depositing one copy of the work with the Copyright Office along with his claim of copyright. 1909 Act § 11.[4] This statutory copyright endured for twenty-eight years, and was renewable for an additional twenty-eight years. 1909 Act § 23.[5] Common law copyright protected a work indefinitely if it remained unpublished

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2 Section 9 of the 1909 Act states, in pertinent part, "Any person entitled thereto by this title may secure copyright for his work by publication thereof with the notice of copyright required by this title; and such notice shall be affixed to each copy thereof published or offered for sale. . . ."

3 Section 10 provides that an author who publishes his work with copyright notice "may obtain registration of his claim to copyright by complying with the provisions of this title, including the deposit of copies, and upon such compliance the Register of copyrights shall issue to him the certificates provided for in section 209 of this title." The requirements for "deposit of copies after publication" are set forth in section 12:

> After copyright has been secured by publication of the work with the notice of copyright as provided in section 10 of this title, there shall be promptly deposited in the Copyright Office or in the mail addressed to the Register of Copyrights, Washington, District of Columbia, two complete copies of the best edition thereof then published, . . .

4 Section 11 of the 1909 Act provides, in pertinent part, "Copyright may also be had of the works of an author, of which copies are not reproduced for sale, by the deposit, with claim of copyright, of one complete copy of such work if it be a lecture or similar production or a dramatic, musical, or dramatico-musical composition; . . ."

5 Section 23 of the 1909 Act provides as follows: "The copyright secured by this title shall endure for twenty-eight years from the date of first publication, . . . [and] the proprietor of such copyright shall be entitled to a renewal and extension of the copyright in such work for the further term of twenty-eight years. . . ."

and unregistered. 1909 Act § 2.[6] Under the 1976 Act, all common law copyrights were converted to statutory copyrights as of January 1, 1978. They now expire at a fixed time, but no earlier than December 31, 2002. 17 U.S.C. § 303 (1982). Publication without copyright notice divested an author of all protection and cast the work into the public domain. *See* 1 M. Nimmer, *Nimmer on Copyright* § 4.01[B] at 4-5 (1985) (hereafter "*Nimmer*").

The concept of "publication" is pivotal in determining copyright validity under the 1909 Act. However, that statute never explicitly defines publication. *See* 1 *Nimmer* § 4.04 at 4-17. As we attempt to unravel the gordian knot of the claims and counterclaims herein, we will further explore this "arcane and unsettled area of law." *American Vitagraph, Inc. v. Levy*, 659 F.2d 1023, 1026 (9th Cir.1981).

The plaintiff has asked for a declaration of his rights regarding the Amos 'n' Andy radio shows broadcast between 1928 and 1948. However, the defendant asserts that the plaintiff has infringed its copyrights in the radio shows *after* 1948, and the Amos 'n' Andy television programs. Since different issues arise as to the copyrights in these three groups of works, we will address each separately.

1. *The 1928-1948 Radio Shows*

The plaintiff claims that the Amos 'n' Andy radio programs from March 1928, through March 1948, are in the public domain and that CBS has no proprietary rights in any part of these programs. CBS concedes that the *scripts* of these programs are in the public domain because, although registered for copyright by the show's creators, Gosden and Correll, the copyright registrations were never renewed. CBS contends, however, that the *broadcasts* of these early radio shows were never "published" and remain protected by common law copyright, converted to statutory copyright under the 1976 Act.

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6 Section 2 of the 1909 Act states, "Nothing in this title shall be construed to annul or limit the right of the author or proprietor of an unpublished work, at common law or in equity, to prevent the copying, publication, or use of such unpublished work without his consent, and to obtain damages therefor."

Public performance of a work is not considered a publication that divests an author of copyright protection. *See* 1 *Nimmer* § 4.08[A]. "[T]he rendering of the performance before the microphone cannot be held to be an abandonment of ownership to it by the proprietors or a dedication of it to the public at large." *Uproar Co. v. National Broadcasting Co.*, 8 F.Supp. 358, 362 (D.Mass.1934), *modified*, 81 F.2d 373 (1st Cir.1935), *cert. denied*, 298 U.S. 670, 56 S.Ct. 835, 80 L.Ed. 1393 (1936). Thus, the radio broadcasts of the Amos 'n' Andy shows were not publications and did not divest Gosden and Correll of their common law copyrights. CBS, as assignee of those rights, remains the copyright proprietor until at least December 31, 2002. 17 U.S.C. § 303 (1982). Since a copyright owner has the exclusive right to reproduce the copyrighted work, prepare derivative works, distribute copies, and perform the work publicly, 17 U.S.C. § 106 (1982), CBS may prohibit unauthorized copying, distribution, or exhibition of the broadcasts, *i.e.*, the sound recordings of the radio shows. However, it does not presently appear that the plaintiff plans to use recordings of any of these broadcasts as part of his play. Consequently, it is immaterial that CBS retains copyrights in these works.

With the broadcasts protected, but not at issue, and the scripts in the public domain, the question becomes, may the plaintiff, as he proposes, freely use any part of these programs "including but not limited to, their title, characters, format, structure, themes, plots, character names and physical embodiments, characterizations and character relationships." Complaint ¶ 2(a) at 2. We cannot make so sweeping a declaration. Admittedly, the plaintiff can incur no liability for copyright infringement by using parts of the public domain scripts. However, if he makes "free use" of the items enumerated above, he may incur other liability. For example, despite loss of copyright protection, the Amos 'n' Andy characters may be protected by the law of trademark or unfair competition. *See* 1 *Nimmer* § 2.12 at 2-177 & n. 25. Consequently, the plaintiff is free to use the 1928-1948 scripts *only* if he does not infringe other property rights of CBS.

2. *The Post-1948 Radio Shows*

CBS asserts that, regardless of the copyright status of the radio shows *prior* to 1948, its copyrights in the programs *after* 1948 are valid. These post-1948 programs, says CBS, are the true source of substantial portions of the plaintiff's early script. While not admitting infringement, the plaintiff has responded to the instant motion by submitting a newly revised script. Fredericks Affidavit, Exhibit E. He has removed the name "Amos 'n' Andy" from the title and, purportedly, deleted all dialogue alleged by CBS to infringe its copyrights. CBS has not yet addressed whether any dialogue in the new script infringes its copyrights. It nevertheless presses its copyright counterclaims, contending that the plaintiff's revisions do not relieve him of liability for preparing and distributing his earlier, infringing script. We agree that if CBS demonstrates unauthorized copying of works in which it has valid copyrights, it is entitled to statutory damages and other relief, despite the plaintiff's recent script changes.

a. *Copyright Validity*

The broadcasts of the post-1948 radio shows, like the earlier broadcasts, were unpublished works protected by common law copyright under the 1909 Act. The remain protected by statutory copyright under the 1976 Act. The scripts of those shows were neither published nor registered for copyright when created. In January and February 1985, CBS registered these unpublished radio scripts with the Copyright Office. The plaintiff suggests that this belated registration is somehow invalid. We cannot agree. The 1976 Act provides,

> At any time during the subsistence of copyright in any published or unpublished work, the owner of copyright or of any exclusive right in the work may obtain registration of the copyright claim by delivering to the Copyright Office the deposit specified by this section together with the application and fee specified by sections 409 and 708.

> Subject to the provisions of section 405(a), such registration is not a condition of copyright protection.[7]

17 U.S.C. § 408(a) (1982). Copyright registration constitutes *prima facie* evidence of copyright validity. 17 U.S.C. § 410(c) (1982). *See Carol Barnhart Inc. v. Economy Cover Corp.*, 773 F.2d 411, 414 (2d Cir.1985). In the absence of any evidence rebutting this presumption of validity, we conclude that CBS holds valid copyrights in the post-1948 radio scripts.

b. *Infringement*

The elements of a claim for infringement are a showing of (1) valid copyright and (2) the unauthorized copying of the copyrighted work. *Warner Bros., Inc. v. American Broadcasting Co.*, 654 F.2d 204, 207 (2d Cir.1981) (hereafter "*Warner v. ABC* (I)"). Copying can rarely be proven directly. Rather, copying may be found upon a showing of (1) access to the copyrighted work and (2) a substantial similarity to that work. *Id.*; *Novelty Textile Mills, Inc. v. Joan Fabrics Corp.*, 558 F.2d 1090, 1092 (2d Cir.1977); *Arnstein v. Porter*, 154 F.2d 464, 468 (2d Cir.1946).

CBS alleges, and it is uncontested, that the plaintiff has read several scripts and listened to recordings of Amos 'n' Andy radio broadcasts.[8] Silverman Deposition at 23-24, 28. Since the plaintiff clearly had access to some, though not necessarily all, of the copyrighted radio programs, we find this prong of the infringement test is satisfied.

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7 Although not a condition of copyright protection, registration is required before a copyright owner can assert a legal claim for infringement. 17 U.S.C. § 411(a) (1982).

8 The plaintiff, who is now thirty-four or thirty-five years old, *see* Silverman Deposition at 7, is too young to have listened to the original Amos 'n' Andy radio broadcasts. One of the recordings he has listened to is a three-record phonograph album entitled "Amos 'n' Andy, The Best Loved Shows: 1946-1953." *See* Silverman Deposition, Exhibit J. This album contains a recording of a radio show entitled, "The 10,000th Broadcast," November 26, 1952, from which CBS claims the plaintiff copied substantial sections of dialogue.

The test of substantial similarity is whether an average lay observer would recognize one work as having been appropriated from another. *Ideal Toy Corp. v. Fab-Lu Ltd.*, 360 F.2d 1021, 1022 (2d Cir.1966). Substantial similarity is often a factual issue not appropriately resolved on a motion for summary judgment. *See Warner Bros., Inc. v. American Broadcasting Co.*, *supra*, 720 F.2d 231, 239 (2d Cir.1983) (hereafter "*Warner v. ABC* (II)"); *Arnstein v. Porter*, *supra*, 154 F.2d at 473-74. However, when the evidence is so overwhelming that a court would be justified in ordering a directed verdict at trial, it is proper to grant summary judgment. *See Midway Mfg. Co. v. Bandai-America, Inc.*, 546 F.Supp. 125, 141 (D.N.J.1982), *aff'd*, 775 F.2d 70 (3d Cir.1985), *cert. denied*, ____ U.S. ____, 106 S.Ct. 1265, 89 L.Ed.2d 574 (1986); *Knickerbocker Toy Co. v. Genie Toys, Inc.*, 491 F.Supp. 526, 528 (E.D.Mo.1980); 3 *Nimmer* § 12.10 at 12-75 & n. 23. CBS has documented specific dialogue sequences from its copyrighted radio shows that the plaintiff has reproduced verbatim in his script entitled "Amos 'n' Andy Go To The Movies." *See* Brownell Affidavit at 3-4. We find that no reasonable person could conclude that these portions of the plaintiff's script were original rather than copied from the specified radio plays.

Having found access, and substantial similarity, the only remaining question is whether the plaintiff's use of the copyrighted material constitutes an unauthorized misappropriation. *See Arnstein v. Porter*, *supra*, 154 F.2d at 468-69. We find that it does. The plaintiff has, without authorization, reproduced parts of CBS's copyrighted works, prepared a derivative work, and distributed copies of that work.[9] He has also improperly

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9 The plaintiff's unauthorized use of the defendant's copyrighted works cannot be characterized as a permissible "fair use" within the meaning of section 107 of the 1976 Act, which provides that

> the fair use of a copyrighted work, including such use by reproduction in copies or phonorecords or by any other means . . . for purposes such as criticism, comment, news reporting, teaching (including multiple copies for classroom use), scholarship, or research, is not an

copyrighted his infringing script as original. Accordingly, we grant the defendant's motion for summary judgment on its first and fifth counterclaims for infringement of its copyrights in the post-1948 Amos 'n' Andy radio programs. The plaintiff's copyright registration, no. PAu 600-029, is declared void.[10] The plaintiff is enjoined from reproducing or distributing that script, and will be liable for damages to be determined at a later time.[11]

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infringement of copyright. In determining whether the use made of a work in any particular case is a fair use the factors to be considered shall include—

(1) the purpose and character of the use, including whether such use is of a commercial nature or is for nonprofit educational purposes;

(2) the nature of the copyrighted work;

(3) the amount and substantiality of the portion used in relation to the copyrighted work as a whole; and

(4) the effect of the use upon the potential market for or value of the copyrighted work.

107 U.S.C. § 107 (1982). *Cf. Werlin v. Reader's Digest Association, Inc.*, 528 F.Supp. 451, 463-64 (S.D.N.Y.1981) (duplicated portions of copyrighted work were so small and insignificant as to be *de minimus*, and, therefore, non-infringing); *Elsmere Music, Inc. v. National Broadcasting Co.*, 482 F.Supp. 741, 743-44 (S.D.N.Y.), *aff'd*, 623 F.2d 252 (2d Cir.1980) (although copied portion of copyrighted composition was more than *de minimus*, its incorporation in a parody constituted a non-infringing fair use of the copyrighted work).

10 Only one registration is mentioned in the defendant's fifth counterclaim, which states that "[o]n or about April 10, 1984 Silverman procured the registration of a claim of copyright in one of [his] scripts (registration no. PAu 600-029. . . ." Defendant's Amended Answer and Counterclaims ¶ 33 at 13. Based on the date of registration, we presume the registered script is "Amos 'n' Andy Go To The Movies." *See supra* note 1. If the plaintiff has obtained registration for "Amos 'n' Andy In Hollywood," it too is deemed void, since the infringing dialogue in that script is virtually identical to the corresponding scenes in "Amos 'n' Andy Go To The Movies." It is not clear whether the plaintiff has obtained copyright registration for his more recent script, "Fresh Air Taxi." However, no evidence is presently before us regarding dialogue in that script that might infringe CBS's copyrights in the post-1948 radio scripts.

11 CBS seeks statutory damages, pursuant to 17 U.S.C. § 504, as well as punitive damages. We view the claim for punitive damages as one for

3. *The Television Shows*

CBS contends that the plaintiff has infringed its copyrights in the Amos 'n' Andy television shows by copying the appearance and costumes of the characters, and the stage settings used for those programs. Initially, we must decide whether CBS holds valid copyrights in the programs. If it does, we must determine if the scope of those copyrights protect the characters' appearance and costumes, and the stage settings. Then, we will consider if the plaintiff has infringed CBS's rights.

a. *Copyright validity*

CBS has presented copyright registrations and renewals for all of the television programs allegedly infringed by the plaintiff. Rabinowitz Affidavit, Exhibit A. As noted above, these registration statements constitute *prima facia* evidence of copyright. *See supra* p. 1350. The plaintiff challenges the validity of these registrations, claiming that many of the programs were "published," without copyright notice, prior to the "date of publication" stated on the registrations. Under the 1909 Act, publication without copyright notice resulted in loss of copyright protection, which could not be restored by subsequent registration. *See* 1 *Nimmer* § 4.01[B] at 4-5.

Most of the registrations list the date of publication as June 1, 1953, when the Amos 'n' Andy series was syndicated for exhibition on non-network television stations. At the time of syndication, each program contained copyright notice. CBS acknowledges that many programs were broadcast without copyright notice prior to syndication, but argues that such

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increased statutory damages for willful infringement pursuant to 17 U.S.C. § 504(c)(2) (1982). Any determination of "willfullness" involves the plaintiff's intent and, as such, is an issue of fact that requires an evidentiary hearing. Accordingly, we reserve the issue of damages for trial.

In addition to seeking statutory damages and a permanent injunction, CBS asks that the plaintiff be required to recall and deliver all copies of his infringing script. Since the plaintiff has revised that script, and the earlier version was not widely circulated and is of relatively little commercial value, we believe an injunction provides sufficient relief. We see no need for impounding the infringing script.

broadcasts did not constitute publication. CBS contends that no publication occurred until syndication, and perhaps not even then.[12] *See Paramount Pictures Corp. v. Rubinowitz*, 217 U.S.P.Q. 48 (E.D.N.Y.1981). *But see* 1 Nimmer § 4.11[B] at 4-55. As discussed earlier, radio broadcasts are considered mere performances, which do not constitute publication. *See supra* p. 1350. The plaintiff contends that television broadcasts should be viewed (no pun intended) differently. To broadcast a television show in the early 1950's, a network often had to send copies of a program to television stations across the country. The plaintiff asserts that this distribution constituted publication.

The common law recognized three ways in which original works could be exposed to the public: "exhibition or performance, limited publication, and general publication. Of these, only general publication results in loss of the common law copyright by the creator." *Burke v. National Broadcasting Co.*, 598 F.2d 688, 691 (1st Cir.), *cert. denied*, 444 U.S. 869, 100 S.Ct. 144, 62 L.Ed.2d 93 (1979).

> Public exhibition is not necessarily a general publication merely because the public generally is shown the work. The test of general publication is whether the exhibition of the work to the public is under such conditions as to show dedication without reservation of rights or only the right to view or inspect it without more. *American Tobacco Co. v. Werckmeister*, 207 U.S. 284 [28 S.Ct. 72, 52 L.Ed. 208] [(1907)]. If the conditions of publication are such that the only right is to look at the copy of the work exhibited there is no general publication. . . .

Patterson v. Century Productions, Inc., 93 F.2d 489, 492 (2d Cir.1937), *cert. denied*, 303 U.S. 655, 58 S.Ct. 759, 82 L.Ed. 1114 (1938). A limited publication "occurs when tangible copies of the work are distributed, but to a limited class of persons

12 We need not decide whether syndication constitutes "publication." CBS mooted that question by registering its copyrights in the Amos 'n' Andy shows with the date of syndication as the date of publication; the statutory period of protection runs from the publication date declared on the registrations.

and for a limited purpose." *Burke v. National Broadcasting Co., supra*, 598 F.2d at 692. "Mere limited publication has been found where the range and purpose of distribution did not suggest that the general public was free to obtain and use the work." *Id.*

In contending that early television broadcasts were general publications, the plaintiff asserts that it was common practice for copies of television programs to be "bicycled," that is, forwarded from one station to another rather than returned directly to the network. Thus, he argues, since CBS did not control the circulation of these copies, the programs are now in the public domain. However, CBS has submitted copies of agreements entered into with affiliate stations for broadcasting the Amos 'n' Andy television programs. These "Affiliation Agreements" contain a clause requiring the immediate return of copies of any program distributed for a single broadcast.[13] The plaintiff next alleges that, because there were so few affiliate stations in the early 1950's, CBS must have distributed copies to non-affiliate stations for the initial broadcast. Since non-affiliate stations presumably would not have signed Affiliation Agreements, the plaintiff implies that CBS had even less control over copies sent to them. Thus, he argues, the broadcasts were general publications. Other than the plaintiff's conclusory statements, there is no evidence in the record to support these allegations. Nevertheless, even if we accept the plaintiff's contentions, distributing copies of the Amos 'n' Andy television shows for synchronized national broadcast, even to non-

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13 Paragraph 4 of CBS's standard Affiliation Agreement reads as follows:

> 4. All programs to be broadcast by the Station hereunder will be delivered by [CBS] to the Station in the form of TV recordings, or otherwise. The Station agrees to observe any limitations [CBS] may place on the use of TV recordings and to return to [CBS] immediately following a single broadcast thereof, at such place as [CBS] may direct, and in the same condition as received by the Station, ordinary wear and tear excepted, each print or copy of the TV recording of each program, together with the reels and containers furnished therewith. Each such TV recording shall be used by the Station only for the purpose herein contemplated.

Clancy Deposition, Exhibit 1 at 3.

affiliate stations, falls far short of general publication. It certainly does not manifest a purpose to surrender all rights in the works and allow the public to copy them. *See National Comics Publications v. Fawcett Publications, Inc.*, 191 F.2d 594, 598 (2d Cir.1951). Rather, the initial broadcasts merely allowed the public "to view . . . [the television shows] without more." *Patterson v. Century Productions*, *supra*, 93 F.2d at 492. This was, at most, a "limited publication, which did not divest CBS of its copyrights in the Amos 'n' Andy television programs."

b. *Scope of Protection*

Under section 3 of the 1909 Act, copyright protection encompasses "all copyrightable component parts" of an author's work.[14] *See Walt Disney Productions v. Air Pirates*, *supra*, 581 F.2d at 754. Scenery, or other mechanical devices used in a dramatic presentation are generally not copyrightable. *See* 1 *Nimmer* § 2.13 at 2-178.2; H. Warner, *Radio and Television Rights* § 34 at 88 (1954). Whether characters are a copyrightable part of a copyrighted work is a much debated issue. *See* 1 *Nimmer* § 2.12; Marks, *The Legal Rights of Fictional Characters*, 25 ASCAP Copyright L.Symp. 35 (1980). Literary characters, if sufficiently delineated, have been found copyrightable. *Nichols v. Universal Pictures Corp.*, 45 F.2d 119, 121 (2d Cir.1930), *cert. denied*, 282 U.S. 902, 51 S.Ct. 216, 75 L.Ed. 795 (1931). Even if the Amos 'n' Andy characters are sufficiently delineated to be copyrightable, since some works containing those characters are in the public domain, the plaintiff argues that anyone may copy them in a derivative work. *See* 1 *Nimmer* § 2.12 at 2-176 to 2-177. CBS, however, alleges that the plaintiff has copied the costumes and appearance of the characters pictured in the Amos 'n' Andy television programs, and that

14 Section 3 of the 1989 Act states,

> The copyright provided by this title shall protect all the copyrightable component parts of the work copyrighted, and all matter therein in which copyright is already subsisting, but without extending the duration or scope of such copyright. The copyright upon composite works or periodicals shall give to the proprietor thereof all the rights in respect thereto which he would have if each part were individually copyrighted under this title.

these artistic representations are protectable component parts of the copyrighted works.

Cartoons, and other graphic representations of characters, have been afforded greater copyright protection than characters described only by words. *See Warner v. ABC* (II), 720 F.2d at 240; 1 *Nimmer* § 2.12 at 2-174; Note, *The Protection Afforded Literary and Cartoon Characters Through Trademark, Unfair Competition, and Copyright*, 68 Harv.L.Rev. 349, 358 (1954). Copyright protection has been found appropriate for characters visually depicted in a movie. *Ideal Toy Corp. v. Kenner Products Division of General Mills Fun Group, Inc.*, 443 F.Supp. 291, 301 (S.D.N.Y.1977). The personification of the Amos 'n' Andy characters on television is analogous to the visual depiction of movie characters. However, we must consider a novel issue: are characters that are in the public domain in a literary work protectable by copyright in an audiovisual presentation? We believe they are. The visual representation of these characters, recorded on film, is the expression of an idea that goes beyond the word portraits in the public domain scripts and is, therefore, protectable by copyright. *See* 17 U.S.C. § 102 (1982); *Sid & Marty Krofft Television Productions, Inc. v. McDonalds Corp.*, 562 F.2d 1157, 1168-69 (9th Cir.1977). Accordingly, we find that duplication of the characters as they appeared on television would infringe CBS's copyrights.

c. *Infringement*

There is no question about the plaintiff's access to Amos 'n' Andy television shows, since he has acknowledged owning a videotaped documentary containing Amos 'n' Andy film clips, and viewing an entire program at the Museum of Broadcasting. Silverman Deposition at 27, 51. Exhibits submitted by the plaintiff also include several videotapes of Amos 'n' Andy programs, which, presumably, the plaintiff has also viewed. Thus, access to the copyrighted works is deemed admitted.

The fact that the plaintiff proposes a production in a different medium (*i.e.*, a stage play rather than a television program) does not bar a claim of infringement. *See Ideal Toy Corp. v. Kenner Products*, *supra*, 443 F.Supp. at 301. However, the

question of substantial similarity prevents us from resolving this claim. Until the plaintiff presents his characters on stage, we cannot tell how closely they duplicate the appearance of the television characters. Accordingly, we must deny this aspect of the defendant's motion for summary judgment and dismiss as unripe the counterclaim for infringement of the Amos 'n' Andy television programs.

B. *Trademark*

The federal law of trademarks, 15 U.S.C. §§ 1051-1127 (1982 & Supp. II 1984) (the "Lanham Act") defines a trademark as

> any word, name symbol, or device or any combination thereof adopted and used by a manufacturer or merchant to identify and distinguish his goods . . . from those manufactured or sold by others and to indicate the source of the goods, even if that source is unknown.

15 U.S.C. § 1127 (1982 & Supp. II 1984). Trademarks protect the public from being deceived as to the source and quality of goods, and protect the mark's owner from infringement of his property rights. *See* 1 J. McCarthy, *Trademarks and Unfair Competition* § 2:1 at 44 (2d ed. 1984) (hereafter "McCarthy"). A mark used to identify and distinguish services, (as opposed to goods) is also within the scope of the Lanham Act. "Titles, character names and other distinctive features of radio or television programs may be registered as services marks. . . ." 15 U.S.C. § 1127 (1982 & Supp. II 1984). A mark need not, however, be registered to be afforded protection under the Lanham Act. *See Warner Bros., Inc. v. Gay Toys, Inc.*, 658 F.2d 76, 78 (2d Cir.1981). In this circuit, the Lanham Act has been held to protect the physical appearances and costumes of entertainment characters, as well as their names. *DC Comics, Inc. v. Filmation Associates*, 486 F.Supp. 1273, 1277 (S.D.N.Y.1980).

A mark will be protected if it is inherently distinctive or has become distinctive through "secondary meaning." Secondary meaning is the association of a mark with its source.

> It contemplates that a word or phrase originally, and in that sense primarily, incapable of exclusive appropriation

> with reference to an article on the market, . . . might nevertheless have been used so long and so exclusively by one producer with reference to his article that, in that trade and to that branch of the purchasing public, the word or phrase had come to mean that the article was his product; in other words, had come to be, to them, his trademark.

G. & C. Merriam Co. v. Saalfield, 198 F.369, 373 (6th Cir. 1912).

CBS asserts trademark rights in the name "Amos 'n' Andy" as well as the names of the characters, and words and phrases repeatedly used on the Amos 'n' Andy programs.[15] The "Amos 'n' Andy" programs were popular on radio for almost thirty years, from 1928 to 1955. The television show was first aired in 1951 and ran in syndication until 1966. During those years, the radio and television shows, and their characters, clearly acquired distinctive meaning in the entertainment industry. As early as 1934, the program's creators, Gosden and Correll, prevailed in protecting their property rights in the name "Amos 'n'

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15 The defendant claims that the plaintiff's script contains, *inter alia*, the following names and phrases that constitute Amos 'n' Andy trademarks:

a. Amos 'N' Andy;
b. Amos Jones;
c. Andrew H. Brown;
d. George ("Kingfish") Stevens;
e. Algonquin J. Calhoun;
f. Sapphire Stevens;
g. Madame Queen;
h. Henry Van Porter;
i. Miss Blue;
j. Lightin';
k. Fresh Air Taxi Co.;
l. The Mystic Knights of the Sea;
m. "Hello folks. This is Amos . . .";
n. "Buzz me, Miss Blue";
o. "splain dat"
p. "Holy mackral";
q. "scuse me for protruding";
r. "battle axe."

Defendant's Statement Under Local Civil Rule 3(g) at 4-5.

Andy." *Feldman v. Amos and Andy*, 68 F.2d 746 (C.C.P.A. 1934).

We find that the name "Amos 'n' Andy," as well as the characters' names and appearances, and other distinctive features of the Amos 'n' Andy radio and television shows, are protectable marks. The words and phrases for which CBS claims trademark protection are not necessarily so distinctive as to constitute marks in their own right. However, if used in an attempt to recreate the characters, the words and phrases become a factor in determining whether the character marks have been infringed.

A claim of trademark infringement under section 43 of the Lanham Act, 15 U.S.C. § 1125(a) (1982), requires a showing of (1) validity, *i.e.*, that the public recognizes the mark or symbol as identifying the claimant's goods or services as distinguished from those of another, and (2) infringement, *i.e.*, use of that symbol by another which is likely to cause public confusion. 1 McCarthy § 15:1 at 657. Although various elements of the Amos 'n' Andy shows are protectable under the Lanham Act, a question remains as to the continued validity of CBS trademarks.

Trademark protection arises from the adoption and use of a distinctive mark. The Lanham Act permits the first user of a distinctive mark to register for statutory protection for a period of twenty years, which may be continually renewed, provided that the mark is being used or its nonuse is excusable. 15 U.S.C. §§ 1058, 1059 (1982).[16] Similarly, the cornerstone for protection of an unregistered, common law trademark is its continued use.

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16 Sections 1058 and 1059 provide, in pertinent part,

> Each certificate of registration shall remain in force for twenty years: *Provided*, That the . . . registrant shall file in the Patent and Trademark Office an affidavit showing that said mark is in use in commerce or showing that its nonuse is due to special circumstances which excuse such nonuse and is not due to any intention to abandon the mark.
>
> * * * * * *
>
> Each registration may be renewed for periods of twenty years from the end of the expiring period upon . . . the filing of a verified appli-

A trademark is deemed abandoned "[w]hen its use has been discontinued with intent not to resume. Intent not to resume may be inferred from circumstances. Nonuse for two consecutive years shall be prima facie abandonment." 15 U.S.C. § 1127 (1982 & Supp. II 1984). *See Poncy v. Johnson & Johnson*, 460 F.Supp. 795, 799 (D.N.J.1978). CBS has not used the trademarks associated with Amos 'n' Andy for twenty years. It asserts that it intends to use the marks in the future and that the prolonged nonuse has been the result of "social changes beyond its control." Memorandum of Law in Support of Motion for Summary Judgement at 27. Temporary suspension of use of a mark due to circumstances beyond the owner's control may not result in abandonment. 1 McCarthy § 17:4 at 776-77. But, self-serving statements of intent to resume at some indefinite future time will not prevail over objective evidence of abandonment. *American Photographic Pub. Co. v. Ziff-Davis Pub. Co.*, 135 F.2d 569, 573 (7th Cir.1943); 1 McCarthy § 17:3C at 773. On the other hand, since abandonment results in forfeiture of property rights, it "should be strictly proved." *Saratoga Vichy Spring Co. v. Lehman*, 625 F.2d 1037, 1044 (2d Cir.1980). Although CBS has made a strong argument in support of its claim that it never intended to abandon the Amos 'n' Andy marks, this issue is a subjective one, which cannot be decided as a matter of law on the motion before us. Consequently, we deny the defendant's motion for summary judgment on its second counterclaim, and reserve for trial the issue of abandonment. Until the validity of CBS's trademarks is determined, the claim of infringement is premature.[17]

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cation therefor, setting forth . . . [the] current use of the mark, or showing that any nonuse is due to special circumstances which excuse such nonuse and it is not due to any intention to abandon the mark.

15 U.S.C. §§ 1058(a), 1059(a) (1982).

17 Trademark infringement is established by showing likelihood of public confusion regarding the owner of the mark. The protection afforded a trademark will depend on a number of factors including the strength of the mark, the similarity between the original and alleged infringing mark, the

C. *Unfair Competition*

The keystone of the law of unfair competition, as with trademark, is the likelihood of confusing the public. 1 McCarthy § 2:3 at 54. Actually, the common law of trademarks is considered part of the broader law of unfair competition. *Jean Patou, Inc. v. Jacqueline Cochran, Inc.*, 201 F.Supp. 861, 863 (S.D.N.Y. 1962), *aff'd*, 312 F.2d 125 (2d Cir.1963).

> It is possible to be guilty of unfair competition even when trademark infringement is not present, if use of a similar but noninfringing mark or device is combined with unfair practices in a manner which is likely to deceive purchasers regarding the origin of goods under all the circumstances.

Fotomat Corp. v. Photo Drive-Thru, Inc., 425 F.Supp. 693, 708-09 (D.N.J.1977). *See Jean Patou, Inc. v. Jacqueline Cochran, Inc., supra*, 201 F.Supp. at 865-66.

Distinctive literary and entertainer characterizations can be protected under the law of unfair competition. 1 McCarthy § 10:19. The plaintiff has indicated a desire to evoke the nostalgia of the Amos 'n' Andy radio and television shows. Whether his ultimate production accomplishes this and, in so doing, is likely to deceive the public as to the source of the show, are

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proximity of the products or services, and the alleged infringer's good faith in using the mark. *Poloroid Corp. v. Polarad Electronics Corp.*, 287 F.2d 492, 495 (2d Cir.), *cert. denied*, 368 U.S. 820, 82 S.Ct. 36, 7 L.Ed.2d 25 (1961). CBS will have to show that the public would believe it sponsored or otherwise approved the use of the mark. *Dallas Cowboys Cheerleaders, Inc. v. Pussycat Cinema, Ltd.*, 604 F.2d 200, 204-05 (2d Cir.1979). This is an issue of fact based on the probable or actual reactions of the public. *American International Group, Inc. v. London American International Corp.*, 664 F.2d 348, 351 (2d Cir.1981). CBS has submitted a survey demonstrating public recognition of "Amos 'n' Andy," and some likelihood that a play entitled "Amos 'n' Andy Go To Hollywood" would be associated with the source of the Amos 'n' Andy radio and television programs. Baiman Affidavit at 2 & Exhibit A. However, the plaintiff is no longer using the name "Amos 'n' Andy" in his title and there may be considerably less public confusion regarding a play entitled "Fresh Air Taxi." Any significant public confusion is more likely to stem from the entire production that from just the title. Consequently, we decline to consider any claim of trademark infringement until the plaintiff actually presents his play.

issues of fact that cannot be decided at this juncture. We must, therefore, deny summary judgment on the defendant's third counterclaim. In addition, since a determination of this claim will depend on the characters as portrayed in the plaintiff's final production, this counterclaim is not ripe for adjudication and must be dismissed.

D. *Dilution*

CBS counterclaims for misappropriation of goodwill and dilution of its marks under New York's law of trademarks, service marks, and business reputation. N.Y.Gen.Bus.Law §§ 360 to 368-e (McKinney 1984). Section 368-d of that statute notes that a claim may be established even in the absence of likely confusion as to source.[18] However, CBS must demonstrate a blurring or a tarnishing of its marks. *Warner Bros. v. ABC* (II), *supra*, 720 F.2d 231 at 248. This will depend on (1) the validity of the marks, and (2) the plaintiff's finished product. If the abandonment issue is determined in CBS's favor, we must still await the plaintiff's production before deciding the dilution claim. Hence, we deny summary judgement on the defendant's fourth counterclaim and dismiss that claim as unripe.

E. *Sanctions—Rule 11*

The plaintiff seeks Rule 11 sanctions against CBS for filing a frivolous and harassing summary judgement motion. We find no such harassment by CBS. Rather, it would not be unreasonable to impose sanctions against the plaintiff for seeking a declaration of his rights to produce a play that he keeps changing when confronted with CBS's allegations of infringement. Since CBS has not sought sanctions against the plaintiff, we will not

18 Section 368-d provides as follows:

> Likelihood of injury to business reputation or of dilution of the distinctive quality of a mark or trade name shall be a ground for injunctive relief in cases of infringement of a mark registered or not registered or in cases of unfair competition, notwithstanding the absence of competition between the parties or the absence of confusion as to the source of goods or services.

N.Y.Gen.Bus.Law § 368-d (McKinney 1984).

impose any at this time. However, we will not allow the plaintiff to prolong this action indefinitely while he continues to revise his script in an effort to avoid further liability.[19]

III. CONCLUSION

The defendant's motion for summary judgement is granted in part and denied in part. The following summarizes our decision:

1. a) The *scripts* of the Amos 'n' Andy radio shows from 1928 to 1948 are in the public domain. CBS, however, retains valid copyrights in the radio broadcasts of those shows. The plaintiff may use the scripts without infringing CBS's copyrights. However, he could be liable for infringing other property rights owned by CBS, if CBS has not abandoned its Amos 'n' Andy trademarks.

b) CBS holds valid copyrights in the scripts and broadcasts of the Amos 'n' Andy radio shows created after August 1948. The plaintiff's script entitled "Amos 'n' Andy Go To The Movies" infringes CBS's copyrights. Consequently, we grant the defendant's motion for summary judgment on its first and fifth counterclaims for infringement of these works. The plaintiff is

19 When the defendant moved to dismiss this suit for lack of a justifiable controversy, we noted that the plaintiff had made substantial preparation to produce his play and had a legitimate apprehension of being sued by CBS if he persisted in his endeavors. Thus, we deemed it appropriate to deny the motion and allow this declaratory judgment action to proceed. We have held herein that CBS has valid copyrights in the Amos 'n' Andy television shows and post-1948 radio shows, the latter of which the plaintiff has already infringed by creating and distributing his early script. The plaintiff, however, has already changed that script. We realize that plays are often not finalized until opening night. But, it is now apparent that, along with the script, the visual presentation and effect of the plaintiff's production will be a significant factor in determining whether the plaintiff is infringing CBS's copyrights or, if still valid, its trademarks in the Amos 'n' Andy shows. For just this reason, we find a lack of justiciable controversy in most of CBS's counterclaims. We are prepared to go forward with a trial on the only remaining factual issue, *i.e.*, whether CBS has abandoned its Amos 'n' Andy trademarks, if the plaintiff wishes that issue tried before proceeding with his production. However, that is the extent of the declaratory relief we will consider.

enjoined from distributing or reproducing his infringing script, and its copyright registration (no. PAu 000-029) is declared void.

c) CBS holds valid copyrights in the Amos 'n' Andy television shows. These copyrights include protection of the characters as they appeared on television. We cannot determine whether plaintiff's work infringes these copyrights, because, until the plaintiff stages his proposed Broadway musical comedy, we cannot compare his characters' appearance with the originals. Consequently, we deny the defendant's motion for summary judgement on its first counterclaim, insofar as it alleges copyright infringement of the Amos 'n' Andy television shows, and dismiss this part of the first counterclaim, without prejudice.

2. The name "Amos 'n' Andy," the names and appearance of the characters, and other distinctive features of the Amos 'n' Andy radio and television shows, are protectable marks. However, a material issue of fact has been raised as to whether CBS has abandoned these marks. Accordingly, we deny CBS's motion for summary judgment on its second, third, and fourth counterclaims for trademark infringement, unfair competition, and dilution. Furthermore, these counterclaims must be dismissed as unripe. Only after the plaintiff presents his play will we be able to determine whether the characters or other aspects of the production actually infringe CBS's marks, blur or tarnish those marks, or confuse the public as to the show's source. Consequently, the defendant's second, third, and fourth counterclaims are dismissed, without prejudice.

3. We decline to impose sanctions against either party at this time.

SO ORDERED.

UNITED STATES DISTRICT COURT

S.D. New York

No. 84 Civ 1894 (GLG)

Aug. 3, 1987

STEPHEN M. SILVERMAN,

Plaintiff,

v.

CBS INC.,

Defendant.

Law Offices of Barry I. Fredericks, New York City (Barry I. Fredericks, Jonathan D. Davis, of counsel), for plaintiff.

Moses & Singer, New York City (David Rabinowitz, Stanley Rothenberg, of counsel), for defendant.

OPINION

GOETTEL, District Judge:

In the early days of radio, THE AMOS 'N' ANDY SHOW, created by Freeman F. Gosden and Charles J. Correll, was among the most popular shows on the air. Throughout the 1930's and 1940's, people across the country gathered around their radios to hear the domestic squabbles of "Kingfish" Stevens and his wife, Sapphire, the misadventures of Andy Brown, and the goings-on at the Mystic Knights of the Sea Lodge. To many, AMOS 'N' ANDY evokes a profound nostalgia of a simpler time.

In 1948, CBS purchased all rights in connection with THE AMOS 'N' ANDY SHOW, and retained Gosden and Correll to continue creating new episodes, which were aired on radio until 1955. In 1951, CBS began broadcasting THE AMOS 'N' ANDY

SHOW on television. The AMOS 'N' ANDY characters, as conceived by Gosden and Correll, were black, and were portrayed on television by black actors. On radio, the roles were played by Gosden and Correll, who were white, although publicity photos showed them in blackface.

In November 1964, CBS withdrew THE AMOS 'N' ANDY SHOW from television syndication. It did this in response to pressure from civil rights groups, especially the N.A.A.C.P., that claimed the show presented a demeaning portrayal of blacks.

Background

The background of this controversy is set forth in our prior decision, 632 F.Supp. 1344 (S.D.N.Y.1986) ("*Silverman I*"), and will not be repeated in its entirety. However, a brief recap may be helpful.

In 1981, plaintiff Steven M. Silverman, an entertainment reporter for the New York Post, wrote to CBS about his idea to create a Broadway musical based on AMOS 'N' ANDY. CBS rejected this idea and refused to grant Mr. Silverman a license to use AMOS 'N' ANDY in his proposed production.

In 1984, Mr. Silverman filed this suit seeking a declaration regarding his right to use the AMOS 'N' ANDY characters and other elements of the old radio and television shows. CBS quickly moved to dismiss the suit for lack of a justiciable controversy. The plaintiff responded that he had made substantial preparations to produce his play and was being hampered from obtaining necessary financing because of the likelihood that CBS would sue for infringement after the show was produced. We found the plaintiff's arguments sufficient to defeat the motion to dismiss.

Thereafter, CBS asserted five counterclaims against Silverman and moved for summary judgment. In deciding that motion, we found as follows: The scripts of the 1928-1948 radio programs are in the public domain, but CBS holds valid copyrights in all of the AMOS 'N' ANDY radio performances, and in the radio scripts after 1948; CBS also holds valid copyrights in all of the AMOS 'N' ANDY television programs. *Silverman I*,

supra, 632 F.Supp. at 1350-55. Moreover, the name AMOS 'N' ANDY, as well as the characters' names and appearances, and other distinctive features of the AMOS 'N' ANDY radio and television shows, are protectable trademarks. *Id.* at 1356-57. We reserved for trial the question of whether, due to nonuse, CBS has abandoned its rights in any marks associated with AMOS 'N' ANDY. That trial having been held, the following are our findings of fact and conclusions of law on the issue of abandonment.

Additional Facts

CBS has not exploited the AMOS 'N' ANDY radio and television series and the trademarks associated therewith (collectively, the "Property") for over twenty years. CBS has no present plan to resume use of the Property at a specific time in the future, but wishes to keep this option open. CBS strongly opposes use of the Property by anyone else.

A significant factor in CBS's desire to keep AMOS 'N' ANDY off the market is its concern with the sensitivity of the subject matter, and its expectation of again being put in disfavor with civil rights groups.

CBS has received numerous requests for licenses to use the Property, and has, for the most part, refused to grant them. The only uses of the Property that CBS has sanctioned have been educational or historical. For example, CBS used excerpts from the AMOS 'N' ANDY television series in a CBS News Special, OF BLACK AMERICA, broadcast in 1968. In 1972, CBS licensed the use of the same excerpts for inclusion in a motion picture entitled MALCOLM X. In 1982, CBS granted a license to the Writer's Workshop to incorporate elements of the Property in a limited run play entitled WHAT EVER HAPPENED TA AMOS 'N' ANDY? In 1983, CBS granted a license to Michael Avery to use excerpts from several television episodes of AMOS 'N' ANDY as part of a one-hour film documentary entitled AMOS 'N' ANDY: ANATOMY OF A CONTROVERSY.

CBS has periodically reconsidered other uses and licensing of the Property, but, to date, has rejected such proposals.

During the years since AMOS 'N' ANDY was withdrawn from broadcast, CBS has not aggressively policed its copyrights or trademark rights. However, when infringements have been brought to its attention, CBS has immediately demanded that infringers cease and desist unauthorized use of the Property.

In 1961, CBS obtained copyright registration for seven AMOS 'N' ANDY television episodes; these were renewed in 1981. In 1978 and 1980, CBS registered approximately 70 more episodes; these copyrights were also renewed in 1981. Between September 1984, and February 1985, CBS sought and obtained copyright registration for approximately 80 AMOS 'N' ANDY radio shows. CBS never sought trademark registration for the marks associated with AMOS 'N' ANDY.

After this litigation began, the plaintiff revised his script and deleted AMOS 'N' ANDY from the title of his proposed Broadway show; he also deleted all dialogue challenged by CBS as infringing.[1] The plaintiff's proposed production is still built around the AMOS 'N' ANDY characters.[2]

Discussion

As defined in the Lanham Act, 15 U.S.C. §§ 1051-1127 (1982), a trademark is "any word, name, symbol, or device . . . adopted and used by a manufacturer or merchant to identify his goods and distinguish them from those manufactured or sold by others." *Id.* § 1127. "Titles, character names and other distinctive features of radio or television programs" are also protectable marks.[3] *Id.* This may include the physical appear-

1 Unfortunately, this did not save the plaintiff from a finding that the prior script had infringed CBS's copyrights. *See Silverman I*, *supra*, 632 F.Supp. at 1352.

2 The primary property right at issue here appears to be the right to use the AMOS 'N' ANDY characters, although, arguably, additional AMOS 'N' ANDY marks will be implicated in the plaintiff's proposed show.

3 The Lanham Act designates these as "service marks." 15 U.S.C. § 1127 (1982). However, since the Act accords the same protection to both service marks and trademarks, we will use the more familiar term "trademarks," or simply "marks."

ance and costumes of entertainment characters. *See Silverman I, supra*, 632 F.Supp. at 1355-56.

Both registered and unregistered marks are protected under the Lanham Act. *See Warner Bros., Inc. v. Gay Toys, Inc.*, 658 F.2d 76, 78 (2d Cir.1981). An unregistered mark is protectable for as long as it continues to be used. Nonuse may result in a finding of abandonment, and a loss of the owner's exclusive rights in the mark. *See* 1 J. McCarthy, *Trademarks and Unfair Competition* § 17:3 (2d ed. 1984).

The Lanham Act provides that "[a] mark shall be deemed to be 'abandoned'—(a) When its use has been discontinued with intent not to resume. Intent not to resume may be inferred from circumstances. Nonuse for two consecutive years shall be prima facie abandonment." 15 U.S.C. § 1127 (1982). Two elements are required for abandonment: (1) nonuse, *and* (2) intent not to resume use. *Saratoga Vichy Spring Co. v. Lehman*, 625 F.2d 1037, 1043 (2d Cir.198). By allowing nonuse for two years to constitute prima facie abandonment, the statute effectively grants a presumption of "intent not to resume use" once the statutory period of nonuse is shown to have elapsed. This presumption is rebuttable, *id.* at 1044, and may be overcome by evidence demonstrating that circumstances do not justify an inference of intent not to resume use. *Sterling Brewers, Inc. v. Schenley Industries, Inc.*, 441 F.2d 675, 679 (C.C.P.A.1971). It must be remembered, however, that a presumption merely imposes on the party against whom it is directed the burden of going forward with evidence to meet or rebut the presumption; it does not shift the ultimate burden of proof in the sense of the risk of nonpersuasion, which remains on the party on whom it was originally cast. *See* Fed.R.Evid. 301.

The facts of this case are reasonably clear, albeit unique. It is the application of existing law to these facts that is troublesome. One of the most unusual aspects of this case is that we are dealing with marks associated with radio and television shows, which are also protected by copyrights. Other abandonment cases reviewed by this Court involve trademarks used in connection with some tangible, consumer product, *e.g.*, beer, bottled water, buttons, and magazines, not similarly subject to copyright protection. No court, to our knowledge, has considered

abandonment of entertainment marks that are simultaneously protected by copyright.[4] We have already ruled that CBS holds valid copyrights protecting the AMOS 'N' ANDY characters. *See Silverman I*, *supra*, 632 F.Supp. at 1355. Thus, regardless of whether or not the AMOS 'N' ANDY marks have been abandoned, unauthorized use of the characters could leave the door open for a copyright infringement suit. The plaintiff, however, has pursued this litigation through trial on the issue of abandonment, and seeks a declaration regarding his right to use any marks associated with AMOS 'N' ANDY, not just the characters. Having come this far, he is entitled to a complete ruling.

CBS has made only limited use of the AMOS 'N' ANDY marks over the last two decades. Although this does not automatically result in loss of all trademark rights, such limited use cannot avoid prima facie abandonment pursuant to 15 U.S.C. § 1127. *See Exxon Corp. v. Humble Exploration Co.*, 695 F.2d 96, 102 (5th Cir. 1983). To retain its rights, CBS must meet the presumption thus created with evidence demonstrating that circumstances do not justify an inference of intent not to resume use. *Sterling Brewers, Inc. v. Schenley Industries, Inc.*, *supra*, 441 F.2d at 679. CBS has come forward with evidence showing licensing of AMOS 'N' ANDY shows for educational and historical purposes, registering and renewing copyrights in over 100 television and radio shows, challenging infringing uses whenever these became known to CBS, and periodically reconsidering revival of the television series. This evidence, coupled with CBS's strenuous assertion of its intent not to abandon these marks, suffices to meet the presumption and shift the burden of persuasion back to the plaintiff to prove abandonment.

The plaintiff argues that CBS is really warehousing the AMOS 'N' ANDY marks, keeping them off the market and yet asserting the right to prevent others from using them. He contends that only "commercial use," or intent to resume commercial use, will allow CBS to retain its rights in the marks. *See Exxon*

4 If copyrights in an entertainment work have expired, a question arises of whether marks associated with that work can continue indefinitely, provided they continue to be used and to retain their significance as a designation of origin and goodwill. However, this is not a question we must now decide.

Corp. v. Humble Exploration Co., *supra*, 695 F.2d at 102, *on remand*, 592 F.Supp. 1226, 1229 (N.D.Tex.1984). In *Exxon* the Fifth Circuit considered whether a trademark owner could retain rights in a mark that was being used only in connection with limited product distribution, as part of a trademark maintenance program. The plaintiffs claimed they did not intend to abandon their rights in the mark, but the Fifth Circuit ruled that the plaintiffs' use of the mark was insufficient to avoid a finding of prima facie abandonment. 695 F.2d at 102. The court stressed that the Lanham Act "does not allow the preservation of a mark solely to prevent its use by others," and that intent not to abandon is different from intent to resume use. *Id.* at 101-02. To maintain a mark in the absence of use, the Fifth Circuit required that the owner have plans to resume commercial use of the mark. *Id.* at 102. On remand, the district court applied the "intent to resume commercial use" standard, but found adequate evidence of such an intent, and ruled that the plaintiffs had not abandoned their rights in the mark. 592 F.Supp. at 1230-31.

In response, CBS notes that "commercial use" is not explicitly required to obtain or sustain a trademark, although use "in commerce" is required for registration of a trademark.[5] *See* 15 U.S.C. § 1051. The *Exxon* case clearly requires intent to resume commercial use of a mark to combat a claim of abandonment. However, *Exxon* is a Fifth Circuit decision, and we must first be guided by Second Circuit precedents on the question of abandonment.

No Second Circuit case has addressed whether prima facie abandonment may only be overcome by proving intent to resume commercial use. We note, however, that the Second Circuit has gone to great lengths to avoid finding a mark abandoned. Hence, we seriously doubt whether the Fifth Circuit's more stringent "commercial use" requirement would be adopted by this Court.

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5 CBS also notes that the amount of use necessary to avoid a finding of abandonment is less than that needed to establish a trademark in the first place. *See Waldes v. International Manufacturers Agency, Inc.*, 237 F. 502 (S.D.N.Y.1916) (L. Hand, J.).

To find a mark abandoned, the Second Circuit requires a showing not only of acts indicating a practical abandonment, but also of " 'actual intent to abandon. Acts which unexplained would be sufficient to establish an abandonment may be answered by showing that there never was an intention to give up and relinquish the right claimed.' " *Wallace & Co. v. Repetti, Inc.* 266 F. 307 (2d Cir.), *cert. denied*, 254 U.S. 639, 41 S.Ct. 13, 65 L.Ed. 451 (1920) (quoting *Saxlehner v. Eisner & Mendelson Co.*, 179 U.S. 19, 31, 21 S.Ct. 7, 11-12, 45 L.Ed. 60 (1900)); *see Saratoga Vichy Spring Co. v. Lehman*, *supra*, 625 F.2d at 1044. This approach is consistent with the statutory language regarding abandonment, which is couched in terms of "intent *not* to resume" rather than "intent *to* resume" use. It is also consistent with the well-established principle that abandonment, being in the nature of a forfeiture, must be strictly proved. *See Citibank, N.A. v. Citibanc Group, Inc.*, 724 F.2d 1540, 1545 (11th Cir. 1984); *Saratoga Vichy Spring Co. v. Lehman*, *supra*, 625 F.2d at 1044; *American Foods, Inc. v. Golden Flake, Inc.*, 312 F.2d 619, 624-25 (5th Cir.1963); *Neva-Wet Corp. v. Never Wet Processing Corp.*, 277 N.Y. 163, 13 N.E.2d 755 (1938).

Two cases are particularly instructive in understanding the Second Circuit's reluctance to declare trademarks abandoned. In *Defiance Button Machine Co. v. C & C Metal Products Corp.*, 759 F.2d 1053 (2d Cir.), *cert. denied*, 474 U.S. 844, 106 S.Ct. 131, 88 L.Ed.2d 108 (1985), the plaintiff, a well established manufacturer and seller of metal buttons and the equipment with which to make such buttons, ceased operations and sold all of its tangible assets, including the means to manufacture the buttons, to defendant C & C Metal Products. The plaintiff hoped, thereafter, to sell its DEFIANCE trademark, and the goodwill purportedly attached thereto, but never received a financially acceptable offer. The plaintiff eventually became a subsidiary of a competing button manufacturer, and sought to resume use of its DEFIANCE mark. The defendants, by then, were using the name DEFIANCE to identify buttons they manufactured using the dies and machinery acquired from the plaintiff. The plaintiff brought suit to enjoin defendants from using this mark. When the case reached the Second Circuit, the plain-

tiff had still not resumed production of buttons. The Circuit court noted that the owner's conduct in attempting to sell the mark and the goodwill associated therewith, and later deciding to resume business, was inconsistent with an intent to abandon its trademark. *Id.* at 1061. Accordingly, the court refused to find the mark abandoned, even though any goodwill associated with the mark had in fact been lost when C & C Metal acquired a copy of the plaintiff's customer list along with the plaintiff's machinery.

In *Saratoga Vichy Spring Co. v. Lehman*, *supra*, the State of New York was forced to discontinue use of the mark SARATOGA GEYSER when the state legislature eliminated appropriations for the operation of a mineral water bottling plant in the Saratoga Springs area. The state thereafter sought to lease the bottling operation. However, litigation with a former distributor prevented this, and the state had to close the plant. Two years after the litigation ended, the state reached a license agreement with a company other than the plaintiff to use the SARATOGA GEYSER mark. The plaintiff brought suit claiming infringement of its SARATOGA VICHY mark. On the issue of whether the SARATOGA GEYSER mark had been abandoned, the Second Circuit stated that "New York's nonuse was caused by the decision of the legislature to have the State withdraw from the mineral water business, and the State thereafter sought continuously to sell the business with its good will and trademark. These facts are completely inconsistent with an intent to abandon the mark." 625 F.2d at 1044.

The circumstances of the instant case are different from either *Definance Button* or *Saratoga Vichy*, in that CBS is not attempting to sell its AMOS 'N' ANDY marks. However, CBS has made it abundantly clear that it does not intend to abandon these marks. It has continued to license limited uses of the Property, to periodically reconsider resuming use, and to challenge infringing uses that have been brought to its attention.[6]

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6 The plaintiff argues that CBS has not forcefully policed its AMOS 'N' ANDY marks. We cannot help but note the inconsistency between this and the plaintiff's prior argument, that declaratory relief should be granted because of the likelihood CBS will sue for infringement if Mr. Silverman pro-

Also, during the past ten years, CBS has registered for, or renewed, copyrights in over 100 of the AMOS 'N' ANDY radio and television shows. These actions are entirely inconsistent with an intent to abandon or relinquish rights in the AMOS 'N' ANDY marks.

An additional factor must be considered in this case. CBS argues that nonuse due to circumstances beyond its control is excusable, and should not result in loss of trademark rights. *See* 1 J. McCarthy, *Trademark and Unfair Competition* § 17:4 (2d ed. 1984). CBS withdrew AMOS 'N' ANDY from syndication in 1964, because of pressure from civil rights groups. During the intervening years, CBS has considered whether the time was right to bring back this series. But, despite the popularity of reruns of other old series such as "The Honeymooners," and recent situation comedies such as "The Jeffersons," and "The Bill Cosby Show," which feature black families, CBS obviously believes that civil rights groups would still find the portrayal of blacks in AMOS 'N' ANDY to be offensive. Although the plaintiff, and even this Court, may disagree with CBS's assessment of the type of reception AMOS 'N' ANDY would receive today, we cannot substitute our subjective perceptions for an objective evaluation of the reasonableness of CBS's actions. *See Poncy v. Johnson & Johnson*, 460 F.Supp. 795, 802 (D.N.J.1978).

Recalling the pervasive racial tension that swept this country in the 1960's, and which remains a continuing problem in many

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duced his show without its consent. This aside, the plaintiff's argument is still unavailing. Failure to police a mark can be evidence of, but does not automatically constitute, abandonment. *See* 1 J. McCarthy *Trademarks and Unfair Competition* § 17:5 (2d ed. 1984). Since CBS has reaped scant financial rewards from the Property since it suspended syndication of the television series in 1964, we find its policing activities have been reasonable, and adequate to belie any intent to abandon its marks.

Failure to police a mark can also cause it to lose its significance as an indication of origin, and, thus, be deemed abandoned. 15 U.S.C. § 1127(b) (1982). Here, however, the plaintiff himself has stressed the strong public recognition of AMOS 'N' ANDY as a factor in his desire to create a Broadway musical based on the old radio and television programs. Numerous other requests for licenses to use the Property further attest to the continued public recognition of AMOS 'N' ANDY.

areas of the country and in many aspects of daily life, we cannot say that CBS's reluctance to revive AMOS 'N' ANDY is unreasonable, given the fact that civil rights groups seem to find the depiction of blacks in AMOS 'N' ANDY to be demeaning. It would be offensive to basic precepts of fairness and justice to penalize CBS, by stripping it of its trademark rights, merely because it succumbed to societal pressures and pursued a course of conduct that it reasonably believes to be in the best interests of the community.

Conclusion

In light of the evidence presented in this case, including (1) CBS's assertion of its intent to resume use of AMOS 'N' ANDY, and the marks associated therewith, if and when the social climate becomes more favorable, (2) its reasonable explanation for nonuse, and (3) its continuing efforts to police and protect its rights in this Property, we find that CBS has not abandoned its rights in the marks associated with AMOS 'N' ANDY. This ruling, together with *Silverman I*, constitutes our entire decision regarding the plaintiff's right to freely use the AMOS 'N' ANDY Property. In a nutshell, he may not. CBS may submit its request for damages on the copyright infringement found pursuant to our decision in *Silverman I*.[7] We will then rule on that request,

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7 The infringement found in *Silverman I* was for unauthorized use of dialogue from several copyrighted radio programs. 632 F.Supp. at 1352. We declined to rule on CBS's other copyright infringement claims, which we found to be premature. *Id.* at 1355. The alleged infringement of CBS's copyrights in the television series is based primarily upon copying of the characters as they appeared on television, and other aspects of the visual presentation of AMOS 'N' ANDY. It is impossible to determine the element of substantial similarity necessary to rule on a claim of copyright infringement, without seeing a fully staged production of the plaintiff's proposed Broadway show. *Id.* A ruling on trademark infringement would be similarly premature, since it too involves consideration of the similarity between the AMOS 'N' ANDY characters as they originally appeared and developed as marks and as they may be cast and costumed in a production of the plaintiff's proposed play. *See id.* at 1357 n. 17.

and on the defendant's motion for attorneys' fees and other sanctions.[8]

SO ORDERED.

8 The defendant's motion for sanctions is directed against plaintiff and three counsel that have represented plaintiff in this action. One predecessor counsel not only opposes imposition of sanctions, but also cross moves for a protective order pursuant to Fed.R.Civ.P. 26(c), claiming attorney-client privilege and attorney's work product privilege.

Relevant Statutory Provisions

15 U.S.C. § 1059. Renewal of registration

(a) Each registration may be renewed for periods of twenty years from the end of the expiring period upon payment of the prescribed fee and the filing of a verified application therefor, setting forth those goods or services recited in the registration on or in connection with which the mark is still in use in commerce and having attached thereto a specimen or facsimile showing current use of the mark, or showing that any nonuse is due to special circumstances which excuse such nonuse and it is not due to any intention to abandon the mark. Such application may be made at any time within six months before the expiration of the period for which the registration was issued or renewed, or it may be made within three months after such expiration on payment of the additional fee herein prescribed.

(b) If the Commissioner refuses to renew the registration, he shall notify the registrant of his refusal and the reasons therefor.

(c) An applicant for renewal not domiciled in the United States shall be subject to and comply with the provisions of section 1051(d) of this title.

15 U.S.C. § 1127. Construction and definitions; intent of chapter (in part)

In the construction of this chapter, unless the contrary is plainly apparent from the context—

* * *

A mark shall be deemed to be "abandoned"—

(a) When its use has been discontinued with intent not to resume. Intent not to resume may be inferred from circumstances. Nonuse for two consecutive years shall be prima facie abandonment.

* * *

List of Subsidiaries of Petitioner, CBS Inc.

Subsidiaries of CBS Inc.*
(as of 03/13/89)

Aspenfair Music, Inc.
Bala Cynwyd Associates [General Partnership]
Beverlyfax Music, Inc.
CBS Broadcast International of Canada Limited
CBS Broadcast Services Ltd.
  CBS Pension Trustees U.K. Limited
CBS FMX Stereo Inc.
CBS/FOX Company, The [General Partnership]
  CBS/FOX VIDEO (Holdings) Ltd.
    CBS/FOX VIDEO Limited
  CBS/FOX VIDEO (Germany) G.m.b.H.
  CBS/FOX VIDEO (South Pacific) Pty Ltd.
  CBS/FOX VIDEO (Canada) Ltd.
  CBS/FOX VIDEO (Espanola) S.A.
  CBS/FOX VIDEO French Film Licensing Corp.
    CBS/FOX VIDEO (France) S.A.
  CBS/FOX VIDEO International S.A.R.L.
  CBS/FOX VIDEO (New Zealand) Limited
  CBS/FOX VIDEO (Far East) K.K.
CBS Gramophone Records & Tapes (India) Ltd.**
CBS/MTM Company [General Partnership]
CBS Urban Renewal Corporation
CJG Productions Inc.
Columbia Television, Inc.
Galatea Productions, Inc.
Katy Film Productions, Inc.
Meadowlands Parkway Associates [General Partnership]

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* Inactive subsidiaries are not included in this listing.

** Subject to agreement of sale dated November 19, 1987 with Sony Corporation; awaiting deferred closing.

The Article From The New York Times, November 17, 1988 Is Being Filed as a Contemporaneous Lodging With This Petition